TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1907

No. [redacted]86.

E. C. ATKINS & COMPANY, APPELLANT AND PLAINTIFF IN ERROR,

vs.

E. B. MOORE, COMMISSIONER OF PATENTS.

APPEAL FROM AND IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

FILED MAY 15, 1907.

(20,719.)

(20,719.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1907.

No. 317.

E. C. ATKINS & COMPANY, APPELLANT AND PLAINTIFF IN ERROR,

vs.

E. B. MOORE, COMMISSIONER OF PATENTS.

APPEAL FROM AND IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., OCTOBER 28, 1907.

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1 In the Court of Appeals of the District of Columbia.

No. 424, Patent Appeal Docket.

In the Matter of the Application of E. C. ATKINS & COMPANY.

In the Court of Appeals of the District of Columbia.

No. 424, Patent Appeal Docket.

In re Application of E. C. Atkins & Company, Serial No. 7998, Filed June 12, 1905, for Registration of Trade-mark "AAA" for Saws of all Kinds.

Petition on Appeal from the Commissioner of Patents.

To the Court of Appeals of the District of Columbia:

Your petitioner, E. C. Atkinson & Company, a corporation duly organized under the laws of the State of Indiana, and having its principal office and place of business in the city of Indianapolis, County of Marion, State of Indiana, respectfully represents:

That it is the proprietor of a certain trade-mark used by it in its business, to wit: "AAA," said trade-mark having been used by it upon saws of all kinds for many years.

That on the 12th day of June, 1905, in the manner prescribed by law, it presented its application to the Patent Office praying that a certificate of registration be issued to it for said trade-mark.

That such proceedings were had in said office upon said application that on the 17th day of January, 1907, it was rejected by the Commissioner of Patents, and the issuing of a certificate of registration was refused it.

That on the sixth day of February, 1907, your petitioner, pursuant to section 9 of the Trade-mark Act approved February 20, 1905, gave notice to the Commissioner of Patents of his appeal to this Honorable Court from his refusal to issue a certificate of registration, to wit: for said trade-mark upon said application, as aforesaid, and filed therein in writing the following reasons of appeal:

1. That the Commissioner erred in holding that an applicant may not include in the statement forming part of an application for a certificate of registration of a trade-mark, any description of the trade-mark.

2. That the Commissioner erred in holding that the language of the amendment to the trade-mark approved May 4, 1906, concerning the description of the trade-mark, prohibits any such description.

2 3. That the Commissioner erred in holding that no certificate of registration could issue upon an application filed prior to the act amendatory of the trade-mark act approved May 4, 1906, after the taking effect of said act, except in accordance with the terms of said act.

4. That the Commissioner erred in holding that where a certificate of registration was ready for issue sixteen (16) days before the taking *of* effect of the act amending the trade-mark act approved May 4, 1906, the issue of such certificate of registration should be withheld, because in ordinary course, and to suit the convenience of the Patent Office, such certificate would not ordinarily issue until July 10, 1906, after the act of May 4, 1906, took effect; although it would easily be possible to have issued said certificate before July 1, 1906, by hastening said certificate forward out of ordinary routine.

5. That the Commissioner erred in not holding that the language "only when needed to express colors not shown in the drawing" in the act approved March 4, 1906, is, in the legislative intent, permissive and not mandatory.

6. That the Commissioner erred in holding that it was impossible to register the mark in question herein until after the act approved May 4, 1906 went into effect, on July 1, 1906.

7. That the Commissioner erred in not issuing the certificate of registration prayed for in said application.

That the Commissioner of Patents has furnished this appellant a certified transcript of the record and proceedings relating to said application for a certificate of registration of said trade-mark, which transcript is filed herewith and is to be deemed and taken as a part hereof.

Wherefore, your petitioner prays that its said appeal may be heard upon and for the reasons assigned therefor to the Commissioner as aforesaid, and that said appeal may be determined and the decision of the Commissioner be revised and reversed, that justice may be done in the premises.

E. C. ATKINS & COMPANY,
By BRADFORD & HOOD,
Its Attorneys.

CHESTER BRADFORD,
Solicitor and of Counsel.

Indianapolis, Indiana, February 11, 1907.

2–389.

UNITED STATES OF AMERICA,

[Vignette.]

DEPARTMENT OF THE INTERIOR, PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the Records of this office of the Record for the Court in the matter of the
3 Application of E. C. Atkins & Company, filed June 12, 1905, Serial Number 7,998, for the Registration of Trade-Mark for Saws.

Cost of this copy is $11.00, and has been paid.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington this 8th day of February, in the year of our Lord one thousand nine hundred and seven and of the Independence of the United States of America the one hundred and thirty-first.

[Seal Patent Office, United States of America.]

E. B. MOORE,
Assistant Commissioner of Patents.

$10, c'k, Received Jun- 12, 1905. Z. Chief Clerk, U. S. Patent Office.

Serial No. 7998, Paper No. O. K.

Application.

Application for Trade-mark Registration.

Petition and Power of Attorney.

To the Hon. Commissioner of Patents:

The undersigned presents herewith a drawing and five specimens (or facsimiles) of its trade-mark; and requests that the same, together with the accompanying statement and declaration,
4 may be registered in the United States Patent Office in accordance with the law in such cases made and proviced.

And it hereby appoints Bradford & Hood, (a firm composed of Chester Bradford and Arthur M. Hood), of the City of Indianapolis Indiana, its attorneys (Registration No. 5227), with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to sign the drawings, to receive the Certificate, and to transact all business in the Patent Office connected therewith.

Signed at Indianapolis, State of Indiana, this 9th day of June 1905.

E. C. ATKINS & COMPANY,
By MERRITT A. POTTER, *Treasurer.*

Statement.

To all whom it may concern:

Be it known, That E. C. Atkins & Company, a corporation duly organized under the laws of the State of Indiana and located in Indianapolis, County of Marion, State of Indiana, and doing business at Nos. 402-410 South Illinois Street in said city and also in New York, N. Y., Memphis, Tenn., Atlanta, Ga., Minneapolis, Minn. Portland, Oregon, Seattle, Wash., San Francisco, Cal., Chicago, Ill., and Toronto, Canada has adopted for its use, a trade-mark of which the following is a description:

The trade-mark consists of a symbol composed of the letters "AAA."

The trade-mark has been continuously used in the business of this corporation, and in the business of its predecessors, the firm of E. C. Atkins & Co., from which it derives its title, since about the month of June 1884.

The class of goods to which the trade-mark is appropriated is tools and cutting instruments, and the particular description of goods comprised in said class upon which said trade-mark is used is saws of all kinds.

The trade-mark is usually displayed on the goods, by etching, stamping or otherwise marking the same upon the blade of the saw, and by inscribing same upon the packages containing such saws.

Add A'.

E. C. ATKINS & COMPANY,
By MERRITT A. POTTER, *Treasurer.*

Declaration.

STATE OF INDIANA, *County of Marion, ss:*

Merritt A. Potter, being duly sworn, deposes and says, that he is Treasurer of the corporation, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said corporation in commerce among the several States, particularly between Indiana and New York, Tennessee, Georgia, Minnesota, Oregon, Washington, California, Illinois, and other States and Territories of the United States and between the United States and foreign nations or Indian tribes, particularly between the United States and Argentine, Austria, Belgium, Bolivia, Brazil, British Honduras, Bulgaria, Canada, Cape Colony, Ceylon, Chili, China, Columbia, Costa Rica, Cuba, Denmark, Equador, Egypt, France, Germany, Great Britain, Holland, Hong Kong, India, Italy, Japan, Mexico, Natal, New Zealand, Nicaragua,

Norway, Portugal, Russia, Siam, Spain, Sweden, Switzerland, Turkey, Uruguay, Venezuela, and other countries and that the description drawing, and specimens (or facsimiles) presented truly represent the trade-mark sought to be registered.

MERRITT A. POTTER.

Subscribed and sworn to before me, the undersigned, an officer duly commissioned and qualified to administer oaths, at Indianapolis, Indiana, the 9th day of June, A. D. 1905.

JAMES A. WALSH,
Notary Public.

[NOTARIAL SEAL.]

2-236.

Room No. 159.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Paper No. 1—1.

All communications respecting this application should give the serial number, date of filing, and title of invention.

J. R. S.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Aug.* 12, 1905.
Mailed " " "

E. C. Atkins & Company, care of Bradford & Hood, Stevenson Building, Indianapolis, Ind.:

Please find below a communication from the Examiner of Trade-marks and Designs regarding your application for Trade-mark filed June 12, 1905; Ser. No. 7998.

F. I. ALLEN,
Commissioner of Patents.

The mark should be described as consisting of a monogram of the letters AAA.

T. A. TENNANT,
Acting Examiner.

6 Serial No. 7998, Paper No. 2.

Amend't A.

Mail Room,
Aug. 30, 1905,
U. S. Patent Office.

E. C. Atkins & Company. Application No. 7998. Filed June 12, 1905. Trade-mark, A.A.A.

INDIANAPOLIS, IND., *August* 28, 1905.

Hon. Commissioner of Patents:

Examiner's Room No. 159, U. S. Patent Office.

In the matter of the above noted Application, in view of office letter dated August 12, 1905, the following is submitted for consideration:

Add to the statement, after the final period, the following:

A'. *The trade-mark is shown with the letters arranged in the form of a monogram.*

This is an application for re-registration of trade-mark No. 11,518, registered September 30, 1884.

As now presented, further consideration is requested.

Very respectfully, BRADFORD & HOOD,
Attorneys for Applicant.

C. B.
rw.

2-236.

Room No. 159.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Paper No. 3—Let.

All communications respecting this application should give the serial number, date of filing, and title of invention.

T.–F.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Oct.* 2, 1905.
Mailed " " "

E. C. Atkins & Company, c/o Bradford & Hood, Indianapolis, Indiana:

Please find below a communication from the Examiner of Trade-Marks and Designs regarding your application for trade-mark, filed June 12, 1905, Serial No. 7,998.

F. I. ALLEN,
Commissioner of Patents.

7 The amendment to the statement has been entered as directed, but it appears to be inapt. It is suggested that the description of the trade-mark be amended to read:

The trade-mark consists of a monogram composed of the letters "A. A. A."

and that the amendment of August 30, 1905, be canceled.

F. L. PITTMAN,
Acting Examiner.

Serial No. 7998, Paper No. 4.

Letter.

Mail Room,
Oct. 6, 1905,
U. S. Patent Office.

E. C. Atkins & Company. Application No. 7998. Filed June 12, 1905. Trade-mark, "A. A. A."

INDIANAPOLIS, IND., *October* 4, 1905.

Hon. Commissioner of Patents:

Examiner's Room No. 159, U. S. Patent Office.

In the matter of the above noted Application, in view of office letter dated October 2, 1905, the following is submitted for consideration:

The suggestion of the Office will not be adopted. The trade-mark is properly described in the statement as it now stands. It is the same trade-mark registered September 30, 1884 by certificate No. 11,518. Nothing has happened since that date to limit or restrict applicant's rights. The trade-mark consists of the letters "A. A. A.," whether in the form of a monogram or otherwise, and applicant does not propose to limit or restrict its rights of more than twenty-one years' standing, and no statement or amendment will knowingly be made which will have that effect.

The application is in proper condition to be passed for publication, and it is requested that that be done without further delay.

Very respectfully, BRADFORD & HOOD,
Attorneys for Applicant.

C. B.
rw.

2-236.

Room No. 159.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Paper No. 5—L.

All communications respecting this application should give the serial number, date of filing, and title of invention.

8 D. DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Nov.* 13, 1905.
Mailed " " "

E. C. Atkins & Company, c/o Bradford & Hood, Indianapolis, Ind.:

Please find below a communication from the Examiner of Trade-Marks and Designs regarding your application for Trade-Mark, filed June 12, 1905, Ser. No. 7,998.

F. I. ALLEN,
Commissioner of Patents.

This case has been recon-idered in connection with the communication of the 6th ultimo and the objection of the last Office letter is repeated.

F. L. PITTMAN,
Acting Examiner.

2-074.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Feb.* 5, 1906.

Petition.

Application of E. C. Atkins & Co.
Serial No. 7,998.
Invention, Trade-Mark for Saws.
Referred to the Examiner in charge of Division 33, who is directed to file an answer on the 10″ day of Feb. 1906, which answer shall exhibit the reasons, if any, why the request of the petition hereto attached should not be granted.

F. I. ALLEN,
Commissioner of Patents.

Serial No. 7998, Paper No. 6.

Petition.

Intf.

Mail Room,
Feb. 5, 1906,
U. S. Patent Office.

In the United States Patent Office.

In the Matter of the Application of E. C. Atkins & Company for Registration of Trade-Mark "A.A.A." Serial No. 1998. Filed June 12, 1905.

Petition.

Hon. Commissioner of Patents.

SIR: Petition is hereby taken from the action of the Examiner requiring that the statement which now reads,

9 "The trade-mark consists of a symbol composed of the letters A.A.A."

be amended to read,

The trade-mark consists of a monogram composed of the letters A.A.A.

This is an application for re-registration of trade-mark No. 11,518, registered September 30, 1884, and the statement above quoted to which objection is made is quoted literally from the statement of said trade-mark No. 11,518. The drawing, insofar as the trade-mark is concerned, is also precisely like the drawing in said trade-mark No. 11,518.

It is true that the letters are shown with the sides of the middle letter somewhat overlying the adjacent sides of the end letters. Neither applicant nor his attorneys are able to see any reason why applicant should be restricted to a monogram form because of this circumstance. The trade-mark is universally known and spoken of in the trade as "the three A's" or "the three A mark." It is believed that there is no more reason why applicant should limit itself to a monogram in the statement than there is that it should limit itself to some peculiar style or variety of type. It is believed that the objection made by the Examiner is wholly untenable, and a reversal thereof is prayed.

Very respectfully,

BRADFORD & HOOD,
Attorneys for Applicant.

C. B.

Indianapolis, Ind., February 3, 1906.

[Endorsed:] Docket clerk, U. S. Patent Office, Feb. 5, 1906.

Serial No. 7998, Paper No. 7.

E. E. G.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *February* 6, 1906.

In the Matter of the Application of E. C. Atkins & Company. Trade-mark for Saws. Filed June 12, 1905. No. 7998.

Petition.

SIRS: You are hereby informed that a hearing on the above petition from the action of the Examiner of Trade-Marks, has been fixed for Tuesday, February 20, 1906, at 10 A. M.

By direction of the Commissioner.

Very respectfully,

C. M. IRELAN,
Chief Clerk,

F.

E. C. Atkins & Company, c/o Bradford & Hood, Stevenson Bldg. Indianapolis, Ind.

10 Paper No. 8.

Examiner's Statement.

D.

United States Patent Office.

Application of E. C. Atkins & Company. Trade-mark. Saws. Filed June 12, 1905. Serial No. 7998.

Before the Commissioner, on Petition.

U. S. Patent Office,
Feb. 9, 1906,
Mailed.

Attorneys: Bradford & Hood, Stevenson Bldg., Indianapolis, Ind.

Examiner's Statement.

This is a petition from the action of the examiner in requiring that the mark be described as shown in the drawing.

Applicant describes the trade-mark as follows:

"The trade-mark consists of a symbol composed of the letters 'AAA.'"

It is suggested that the description of the trade-mark presented for registration is not an accurate description of the mark as shown in the drawing and specimens. The trade-mark as shown in the drawing and specimens is a monogram composed of the letters "AAA," and it is believed that the requirement to describe the mark in such terms is correct in view of the ruling in *ex parte* The Carborundum Company (118 O. G., 2250).

The question, whether a mark which consists of the letters "AAA" arranged in any form would be an infringement of the mark shown by applicant, it is thought, should be left to the courts to determine.

Very respectfully, E. L. CHAPMAN,
Examiner, Trade-marks and Designs.

February 9, 1906.

Serial No. 7998, Paper No. 8½.

Mail Room,
Feb. 15, 1906,
U. S. Patent Office.

In the United States Patent Office.

In re Application of E. C. Atkins & Company. Trade-mark. Saws.
Filed June 12, 1905. Serial No. 7998.

Before the Commissioner of Patents.

Reply to Examiner's Statement.

The Examiner says:

The question, whether a mark which consists of the letters
11 "AAA" arranged in any form would be an infringement of the mark shown by applicant, it is thought, should be left to the courts to determine.

This is believed to present the whole question at issue. How *could* the courts *possibly* determine—or be at liberty to determine—this question, if the applicant should *specifically limit himself* in his statement to a monogram.

Besides, it is not believed that the trade-mark presented is a "monogram" in the true sense of that term. The Honorable Commissioner is respectfully referred to the Century Dictionary as supporting this view. What is presented is simply the letters "AAA," the central one of which is somewhat larger than the others, as drawn, and which has its legs overlying or superimposed upon the adjacent legs of the other two. They are not interwoven, each being a unitary character, so that no part of either of the A's is used to make a part of either of the other A's.

Ex parte The Carborundum Company (118 O. G., 2250) is not believed to have any bearing upon the question here presented. The Examiner of Trade-Marks has a fashion of citing this authority in almost every case which comes before him; but it is not believed to acquire any additional significance because of a multiplication of inapt citations of it.

A reversal of the Examiner's decision as prayed for in the petition is still believed to be proper.

Very respectfully,

E. C. ATKINS & COMPANY,
By BRADFORD & HOOD, *Attorneys.*

Indianapolis, Indiana, February 12, 1906.

Feb. 20, 1906. N. L. M.

Serial No. 7998, Paper No. 9.

Comm'r's Decision.

Recorded, Vol. 85, Page 15.

United States Patent Office.

Ex parte E. C. Atkins & Company.

Trade-Mark for Saws.

Petition.

Application filed June 12, 1905, No. 7998.

Messrs. Bradford & Hood for applicant.

This is a petition from the action of the examiner of trade-marks requiring modification of the description of the mark.

The mark as shown on the drawing consists of three A's,
12 slightly overlapping. The mark is described by the applicant as composed of the letters "AAA." The examiner has required that the mark be described as a monogram. The applicant contends that the mark is not a monogram. I do not find it necessary to decide whether the mark is or is not a monogram. The description given by the applicant is correct as far as it goes and in my opinion is sufficient.

The petition is granted.

F. I. ALLEN,
Commissioner of Patents.

April 20, 1906.

Serial No. 7998, Paper No. 10.

Notice of Comm'r's Decision.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *April* 20, 1906.

In the Matter of the Application of E. C. Atkins & Company. Trade-Mark for Saws. Filed June 12, 1905. Serial No. 7998.

Petition.

SIR: You are hereby informed that the above petition has been granted by the Commissioner. Please find enclosed herewith copy of the decision.

By direction of the Commissioner.

Very respectfully,

C. M. IRELAN,
Chief Clerk,

F.

E. C. Atkins & Company, c/o Bradford & Hood, Stevenson Bldg., Indianapolis, Ind.

2-237.

Trade-Mark Division.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Paper No. 11.

All communications respecting this application should give the serial number, date of filing, and title of invention.

C. E. R.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *April* 27, 1906.
Mailed " " "

E. C. Atkins & Company, c/o Bradford & Hood, Indianapolis, Ind.:

Your application for the Registration of a Trade-Mark for a symbol composed of the letters "AAA," for Saws of all Kinds,
13 filed June 12, 1905, Ser. No. 7998, has been examined and passed for publication, in compliance with section 6 of the act authorizing the Registration of Trade-Marks, approved February 20, 1905.

The mark will be published in the Official Gazette of May 15, 1906.

Any person who believes he would be damaged by the registration of this mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication thereof, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section 2 of the act of February 20, 1905.

If no notice of opposition is filed within said time the Commissioner may issue a certificate of registration.

Copies of the Trade-Mark portion of the Official Gazette containing the publication of the mark may be obtained as soon as published at five cents each. Coupons are receivable therefor.

Respectfully,

F. I. ALLEN,
Commissioner of Patents.

Room No. 159.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Paper No. 12—L.

All communications respecting this application should give the serial number, date of filing, and title of invention.

D.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *June* 21, 1906.
Mailed " " "

E. C. Atkins & Company, c/o Bradford & Hood, Indianapolis, Ind.:

Please find below a communication from the Examiner of Trade-

marks and Designs regarding your application for Trade-mark filed June 12, 1905, Ser. No. 7998.

F. I. ALLEN,
Commissioner of Patents.

Attention is directed to the act approved May 4, 1906, providing for a description of the trade-mark itself only when needed to express colors not shown in the drawing.

Inasmuch as the trade-mark covered by this application can not be registered until after July 1, 1906, when said act takes effect, applicant should direct the cancellation of the present description and of all of the preamble to the statement following the words "have adopted for my use," and the substitution therefor of the following words:

the trade-mark shown in the accompanying drawing

If colors form a material part of the mark, a brief reference thereto should follow:

14 An amendment as above indicated should be promptly filed to avoid delay in the use of the certificate.

The class of goods should be set up as, Class 20, Cutlery not included in class 61, and edge-tools.

F. L. PITTMAN,
Acting Examiner.

Serial No. 7998, Paper No. 13.

Letter.

Mail Room,
Jun- 30, 1906,
U. S. Patent Office.

U. S. Patent Office.

Examiner's Room No. 159.

E. C. Atkins & Company. Application No. 7998. Filed June 12, 1905. Trade-mark for Saws.

INDIANAPOLIS, IND., *June* 28, 1906.

Hon. Commissioner of Patents:

In the matter of the above noted Application, in view of office letter dated June 21, 1906, the following is submitted for consideration:

This application was filed under the law as it now exists. Because of actions on the part of the Examiner which upon petition were overruled, the application has been delayed. It is understood to be ready for allowance—that is, ready to be passed for publication.

It is believed that as the applicant has complied with all requirements of the law as it now exists that it is entitled to have the case go forward without waiting for the taking effect of a new law. No

reason is seen why an applicant should change a pending application to the practice prescribed by the new law, unless he should so elect.

It is respectfully requested that the application be passed to issue.

Very respectfully, BRADFORD & HOOD,
Attorneys for Applicant.

C. B.
rw.

2–236.

Room No. 159.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Paper No. 14—L.

All communications respecting this application should give the serial number, date of filing, and title of invention.

15 J. R. S. DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *July* 16, 1906.
Mailed " " "

E. C. Atkins & Company, c/o Bradford & Hood, Indianapolis, Ind.:

Please find below a communication from the Examiner of Trade-marks and Designs regarding your application for trade-mark, filed June 12, 1905, Ser. No. 7998.

F. I. ALLEN,
Commissioner of Patents.

This case has been further considered, in connection with the communication filed the 30th ult.

The examiner has no authority to pass this application to registration as long as there is a description retained in the application and without a proper title of the class of merchandise.

The Act approved May 4, 1906, inhibits registration where a description of the mark is retained, except where color forms a part thereof. The question of color does not enter into this application. Applicant, therefore, is called upon to cancel the present description of the mark and substitute therefor the following:—has adopted for its use the trade-mark shown in the accompanying drawing.

The class of merchandise should be changed from "cutting instruments" to read "Class 20, Cutlery not included in Class 61, and edge-tools."

The last sentence of the statement, which reads as follows, "The trade-mark is shown with the letters arranged in the form of a monogram," should be canceled, inasmuch as this sentence is also a description of the mark.

E. L. CHAPMAN, *Examiner.*

2–074.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Nov.* 8, 1906.

Petition.

Application of E. C. Atkins & Co.
Serial No. 7998.
Invention, Trade-Mark.
Referred to the Examiner in charge of Division Trade-Marks, who is directed to file an answer on the 13″ day of Nov. 1906, which answer shall exhibit the reasons, if any, why the request of the petition hereto attached should not be granted.

F. I. ALLEN,
Commissioner of Patents.

16 Serial No. 7998, Paper No. 15.

Petition.

Mail Room,
Nov. 8, 1906,
U. S. Patent Office.

Int.†

In the United States Patent Office.

In the Matter of the Application of E. C. Atkins & Company for Registration of Trade-mark "A.A.A." Serial No. 7998. Filed June 12, 1905.

Petition.

Hon. Commissioner of Patents.

SIR: This petition is taken from the action of the Examiner of Trade-marks wherein he states—

The Examiner has no authority to pass this application to registration as long as there is a description retained in the application and without a proper title of the class of merchandise.

The history of this application, briefly, is as follows:

After sundry actions by the Examiner, believed by applicant to be wrongful, a petition was taken to the Honorable Commissioner, who, after the hearing, overruled the Examiner and held that the application was in suitable form.

The application was then passed for publication May 15, 1906.

When the thirty days had expired, June 14, 1906, the application

should have in due course been allowed. But as the time within which the certificate of registration would ordinarily be issued, would more than consume the intervening time between June 14, 1906 and July 1, 1906, the date when the amendment to the law went into effect, the Examiner declined to proceed further in the matter.

It is respectfully submitted that as applicant's rights were fully matured under the law as it stood at the time of the real actions in this case, that the registration ought to have been completed.

We therefore respectfully petition that the Examiner be directed to pass this application to registration in its present form, as applicant's rights have not only become vested, but had been so decided to be, before the amendment to the law went into effect.

Respectfully submitted,

E. C. ATKINS & COMPANY,
By BRADFORD & HOOD, *Attorneys.*

C. B.
mc.

[Endorsed:] Docket clerk, U. S. Patent Office, Nov. 8, 1906.

17 Serial No. 7998, Paper No. 16.

E. E. G.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *November* 9, 1906.

In the Matter of the Application of E. C. Atkins & Company. Trade-mark for Saws. Filed June 12, 1905. No. 7998.

Petition.

SIRS: You are hereby informed that a hearing on the above petition from the action of the Examiner of Trade-Marks, has been fixed for Thursday, November 22, 1906, at 10 A. M.

By direction of the Commissioner.

Very respectfully, C. M. IRELAN, *Chief Clerk.*
F.

E. C. Atkins & Co., c/o Bradford & Hood, Stevenson Bldg., Indianapolis, Ind.

[†In pencil in copy.]

Paper No. 17.

Examiner's Statement.

J. R. S.

U. S. Patent Office,
Nov. 16, 1906,
Mailed.

The United States Patent Office.

Application of E. C. Atkins & Company. Trade-marks, Saws. Filed June 12, 1905. Serial Number 7998.

Before the Commissioner, on Petition.

Attorney: Bradford & Hood, Stevenson Building, Indianapolis, Ind.

Examiner's Statement.

Applicant petitions form the action of the examiner in requiring amendment to this application by the cancellation of the description of the mark and the setting forth of the class of merchandise according to the classification established under the Act approved May 4, 1906.

It appears from the record in this case that the trade-mark referred to by this applicant was published in the Official Gazette of May 15, 1906, and that the time allowed for filing oppositions expired thirty days thereafter, namely, on June 14, 1906. This application, therefore, could not have been taken up for registration until
18 June 15, 1906, and if passed for registration between June 15, 1906 and June 21, 1906 would have been registered on July 10, 1906, after the act approved May 4, 1906 had taken effect.

Inasmuch as registration could not have been effected before July 1, 1906, after the act approved May 4, 1906 took effect, applicant was required to amend this application in accordance with the provisions of said act of May 4, 1906, by changing the class of merchandise to read "Class 20, Cutlery not included in Class 61, and edge-tools," and by cancelling the description of the mark, which reads as follows, "has adopted for its use, a trade-mark of which the following is a description: The trade-mark consists of a symbol composed of the letters 'AAA,'" and substituting therefor the following matter, *has adopted for its use the trade-mark shown in the accompanying drawing.*

Applicant was also required to cancel the last sentence of the statement, which reads as follows, "The trade-mark is shown with the letters arranged in the form of a monogram" inasmuch as this sentence involves a description of the mark.

Section 1 of the Act of February 20, 1906, required, among other things, a description of the trade-mark itself. This adding thereto

the words "only when needed to express colors not shown in the drawing." This amendment to the Act of February 20, 1905, took effect July 1, 1906, and after that date section 1 of the Act of February 20, 1905, existed only in the amended form.

Applicant contends that because this application was published its rights were fully matured under the Act of February 20, 1905, before its amendment, and that its rights had become vested, and had so been decided to be before the amendment to the law went into effect.

This contention is believed to be erroneous. The fact that a mark is published in the Official Gazette does not vest any rights in the applicant. The publication of a mark is merely an incident to the examining of the application. It is for the purpose of bringing to the attention of the Office any facts which may preclude a registration to an applicant, which facts are not within the knowledge of the Office, such as oppositions by parties who would be damaged by registration, and if such oppositions are filed, if they be sustained, registration is necessarily refused. Furthermore, interference may be declared after publication of a mark and the judgment of such interferences may be adverse to the applicant. New references may also be found, or other reasons may appear why registration should be refused, and the examiner may properly refuse registration of a trade-mark after its publication, even where no notice of opposition has been filed, if there *by* any legal bar to registration. In this connection attention is directed to the decision in *ex parte* Cluett, Peabody & Co., (120 O. G., 902).

A right cannot be considered as vested in an applicant until a decision awarding him that right becomes final and, as above stated, the publication of a trade-mark is not a final decision by the examiner, or by the Commissioner, that applicant is entitled to a registration.

19 Furthermore, the registration when effected must be under the provisions of a statute in force at the time of registration. It cannot be effected under the provisions of a statute which is no longer in force, and section 1 of the Act of February 20, 1905, is no longer in force in its original form, but only as amended by the Act approved May 4, 1906.

The act of May 4, 1906, made no exception as to cases *pending* at the time of its passage; it was a remedial act intended to avoid certain evils of the Act of February 20, 1905. "Remedial Statutes must be construed with reference to the evils intended to be provided against." (Virginia Coupon Cases, 25 Fed. Rep., 666.)

"Former statutes are not to be resorted to as controlling where changes in phraseology seem to indicate a purpose to change the law." (Bate Refrigerating Co. *v.* Sulzberger, 56 F. R., 713.)

"Amendments to statutes are to be construed so as to avoid 'two diverse and contradictory policies in the same statute.'" (Yuengling *v.* Schile, 12 F. R., 97.)

"Statutes which are remedial will be given a retrospective effect, unless they direct to the contrary. Where, therefore, an act of

Congress enlarges the jurisdiction of the Circuit Court, it will be construed to apply to cases pending and undetermined at the passage of the act, unless excluded by its terms or by necessary implication from the language of the act." (Karken *vs.* Saffarans, 15 F. R., 147.)

To hold that the Act of May 4, 1906, did not apply to cases already pending at the time when it took effect would result in confusion and uncertainty, inasmuch as some cases registered after July 1, 1906, would appear with a description of the mark and with a class of merchandise not set up in accordance with the classification established under the Act of May 4, 1906, while other cases would be registered without a description and with a class of merchandise set up in accordance with the classification established under the Act of May 4, 1906.

Such a course of procedure would result in endless confusion to the Office and to applicants and registrants and it is held that the Act of May 4, 1906, should not be so construed as to permit such a condition in the absence of an express provision in the Act excepting its application to cases pending at the time when it took effect.

Further, it does not appear that any right of the applicant is prejudiced by the requirements made in this case. The registration will issue for the same goods and for the same mark, which is the trade-mark shown in the accompanying drawing. The mark is not changed in any way by the omission of the description, nor does applicant secure registration for anything different from his actual trade-mark, if a description is included in his application.

In so far as the statement of the class of merchandise is concerned, it is believed to be immaterial to the applicant whether the title of the class is set up as "tools and cutting instruments," as it now appears in this application, or as Class 20, Cutlery not included in Class 61, and edge-tools. The trade-mark covers saws of all kinds, this being the particular description of goods, and it covers nothing else, no matter in what class of merchandise these goods are stated to be comprised.

For the above reasons, it is believed that this petition should be denied.

Very respectfully, F. L. PITTMAN,
Acting Examiner of Trade-marks and Designs.

November 16, 1906.

A.† Chapman.† O.†

T. M. Serial No. (Series of 1905) 7,998. Div. [33].* (Ex'r's Book) 33–12.

1905.

Trade-mark No. —.

Act of February 20, 1905.

Name: E. C. Atkins & Company, of Indianapolis, Ind.; New York, N. Y.; Memphis, Tenn.; Atlanta, Ga.; [county of]* Minneapolis, Minn.; Portland, Ore.; Seattle, Wash.; [State of]* San Francisco, Cal.: Chicago, Ill., and Toronto, Canada.

For saws.

Parts of application filed.
- Petition, June 12, 1905.
- Declaration, " " 1905.
- Statement, " " 1905.
- Specimens, " " 1905.
- Drawing, " " 1905.
- 1. Fee, cash, $10, June 12, 1905.
- " cert. dep., ——, 190–.
- Appl. filed complete June 12, 1905.

Examined for publication, E. L. Chapman, Apr. 26, 1906. P.
Examined for registration, ——, 190–.
Registration.†
Countersigned: ——, 190–, —— ——, for Commissioner.
Notice of allowance, ——, 190–.
Registered, ——, 190–.
Representative, —— ——.
Attorney-, Bradford & Hood, Stevenson bldg., Indianapolis, Ind.
2. Associate attorney, —— ——.
T. M. Serial No. 7998.
Date of filing, ——, 190–.
Trade-mark No. —.
Registration, ——, 190–.
3. Published in O. G. May 15, 1906.

[* Words and figures enclosed in brackets erased in copy.]
[† In pencil in copy.]

Ser. No. 7998

No 424 Patent Appeals
In the matter of the application of E.C. Atkins & Co. } f. 39 21½

Proprietor:
E.C. Atkins & Company
By Bradford & Hood
Attorneys.

21

Classification.

Tools.†

Trade-mark,
Tools and Cutting Instruments.

1905.

Contents.

Application, — papers. O. K. 20.†
1. Letter, Aug. 12, 1905.
2. Amend't A, Aug. 30, 1905.
3. Letter, Oct. 2, '05.
4. Letter, Oct. 6, 1905.
5. Let., 11, 13, '05.
6. Petition, Feb. 5, 1906.
7. Notice of hearing, Feb. 6, 1906.
8. Ex. stat., 2, 9, 1906.
8½. Brief for petitioner, Feb. 15, 1906.
9. Commissioner's decision, April 20, 1906.
10. Notice of Commissioner's decision, April 20, 1906.
11. P. N., April 27, 1906.
12. Let., June 21, 1906.
13. Letter, June 30, 1906.
14. Letter, July 16, 1906.
15. Petition, Nov. 8, 1906.
16. Notice of hearing, Nov. 9, 1906.
17. Examiner's statement, Nov. 16/06.

Trade-mark:
A symbol composed of the letters AAA.

Merchandise,
Saws of all kinds.

(Here follows drawing marked p. 21½.)

[* Words and figures enclosed in brackets erased in copy.]
[† In pencil in copy.]

22 E. C. Atkins & Company. Application No. 7988. Filed June 12, 1905. Trade-mark "AAA" for Saws.

Bradford & Hood.

1235 State Life Building.

INDIANAPOLIS, IND., *Nov.* 19, 1906.

Hon. Commissioner of Patents, Examiner's Room, No. 159, U. S. Patent Office.

SIR: In the matter of the above noted Application, in view of office letter dated —— —, —, the following is submitted for consideration:

Amend the statement by cancelling the words "of which the following is a description" on page 1, and all of page 2 except the signature, and substituting

which is illustrated in the accompanying drawing, and which consists of the letters "AAA."

The trade-mark has been continuously used in the business of this corporation and in the business of its predecessor, the firm of E. C. Atkins & Co., from which it derives its title, since about the month of June, 1884.

The class of goods to which the trade-mark is appropriated is class 20, cutlery not included in class 61, and edge tools, and the particular description of goods comprised in said class upon which said trade-mark is used is saws of all kinds.

The trade-mark is usually displayed on the goods by etching, stamping or otherwise marking the same upon the blade of the saw, and by inscribing the same upon the packaged containing such saws.

By this amendment applicant is substantially and sufficiently complying with all the requirements of the Examiner, except that there is included in the statement, as thus amended, the words and letters "and which consists of the letters AAA."

Applicant is, therefore, not insisting upon a matter of form, and is quite willing that there shall be embodied in its statement the present classification, so long as it is permitted to use language which includes a sufficient- broad statement of what its mark really is.

This proposed amendment is submitted in connection with the argument, in order that no misapprehension as to just what applicant is willing to do may exist.

Very respectfully, BRADFORD & HOOD,
Attorneys for Applicant.

C. B.
mc.

23 Docket Clerk,
Nov. 22, 1906,
U. S. Patent Office.

In the United States Patent Office.

In the Matter of the Application of E. C. Atkins & Company for Registration of Trade-mark "AAA." Serial No. 7998. Filed June 12, 1905.

Before the Commissioner of Patents.

Petition.

Reply to Examiner's Statement.

Hon. Commissioner of Patents.

SIR: The Examiner does not object to or criticise the statement of facts set forth in the petition, and said facts are therefore presumed to be admitted.

The Examiner bases his whole contention upon the statement that there was not sufficient time between June 14, 1906, and July 1, 1905, to have issued the trade-mark. This is assumed to mean that the time between said two dates is not as long as is usually taken between allowance and issue. That is to say, the Patent Office, merely for its own convenience, withholds actual delivery of the Certificate of Registration, after the date of allowance, for a period somewhat longer than the number of days between June 14, 1906, and July 1, 1906. Nothing in the law, or in the rules, requires this withholding. There is no reason, so far as the law is concerned, why the certificate should not be delivered on the very date of the allowance of the application.

We may remark in passing that applicant would have no objection to remodeling the statement in a manner to make it correspond substantially to present practice if there is permitted to be included language stating in what the trade-mark consists. A proposed amendment will be submitted in connection with the hearing.

What the Statute Requires.

The Examiner cites *ex parte* Cluett, Peabody & Co., 120 O. G. 902, as supporting his proposition that "the Examiner may properly refuse registration of a trade-mark after its publication, even where no notice of opposition has been filed, *if there be any legal bar to registration.*"

No authority is needed upon this point—at least applicant is making no contention against this position. The Examiner has not shown in this case that there is "any *legal bar* to registration."

But the reasoning of the Cluett, Peabody & Co. case seems to be distinctly against the present contention of the Examiner. He

treats the phrase "only when needed to express colors not
24 shown in the drawing" inserted by the amendment to the trade-mark Act approved May 4, 1906, as *prohibitive* of any description of the mark. In the Cluett, Peabody & Co. case it was held that "the word 'shall' is to be understood as *permissive* but not as mandatory." We contend that it is quite as clear that the language "only when needed to express colors not shown in the drawing" is, in the legislative intend, *permissive,* and *not* mandatory. In other words, the law means the same as though it read

a description of the trade-mark itself, *which shall be required* only when needed to express colors not shown in the drawing.

If the suggested words "which shall be required" had actually been included in the law, there could have been no controversy on the subject; but that the law as it reads permits (if it does not require) these words to be understood, seems clear.

We contend, therefore, that even under the law as it now reads, an applicant has the right, if he so elects, to appropriately describe the mark in the statement.

In this connection, the attention of the Honorable Commissioner is called to the decision of the Court of Appeals of the District of Columbia, in the case of the Standard Underground Company (No. 340).

In the drawing in the present case, as in the Standard Underground Company case, there are various embellishments shown, which, in applicant's opinion, are not a part of the trade-mark, and which should not be required to be included therein, either specifically or by means of such proceedings as would reasonably lead to the inference that they are so included.

In reply to the argument that the trade-mark is not granted by, but merely registered in, the Patent Office; and that, therefore, the scope of an applicant's rights is not determined or affected by said registration, it may be said that (that being admitted) it does not meet the situation. While it is probably true that it is not in the power of the Patent Office to enlarge or directly limit the character or scope of trade-mark rights, it *is* in the power of the Patent Office, if the contention of the Examiner be upheld, to *indirectly* limit those rights by requiring an applicant to embody in his application limiting matter. If in the present case the applicant shall comply with the requirement, and specifically limit his trade-mark to *the* illustration "shown in the drawing," we are of the opinion that applicant's rights might be thereby materially reduced.

This trade-mark is the most valuable and widely known of all the many which this applicant owns. It is known to the trade, far and wide, that the "three A" mark, and any possible arrangement of these three letters would be an infringement of applicant's real rights. But if applicant is required to limit itself to *the* particular illustration of *the* drawing, which includes considerable ornamental matter and artistic embellishment, then applicant's rights may be materially lessened.

Applicant might perhaps file a new drawing in which there should appear only the letters, separate and apart from any ornamentation or accessories. But its most common use of the mark is in connection with the matter illustrated, and it seems desirable that the drawing should illustrate the preferred style of use.

It is therefore believed that it is proper to permit a trade-mark to be registered with a statement including a brief description of the mark, where the applicant so desires, even under the law as it now exists.

But in the present case, the rights of applicant had fully matured by the reversal of the Examiner by the Honorable Commissioner on April 20, 1906, except a compliance with the requirement of publication. The Examiner, for some reason not known to applicant, delayed the publication for nea-ly four weeks; and then, because (after such delay) there was a few days' less time than is usually consumed by office routine between the expiration of the thirty days after publication and the taking effect of the amendment to the law, arbitrarily refuses to allow the application.

This is a wrong, under color of official authority, to which applicant is not disposed to submit, if by any means whatever the wrong can be corrected.

The Court authorities cited by the Examiner are not believed to be pertinent. The Virginia Coupon Cases was where the Federal Court remanded a case to the State Courts. The quotation by the Examiner is incomplete. The complete quotation reads as follows:

Remedial statutes must be construed with reference to the evils sought to be remedied, and not enlarged to embrace matters, incongruous in nature, which could not have entered into the contemplation of the legislature.

The other cases are equally inapplicable.

We submit herewith several exhibits showing a number of the forms in which this trade-mark has actually been used. We also append certain affidavits from dealers in saws as to their understanding of the real character of this trade-mark. The Examiner has not denied the facts thus shown, but they are believed to be relevant as showing how an injustice might be done if the ruling of the Examiner should be sustained, and applicant's rights thus inferentially limited.

It is respectfully submitted that the ruling of the Examiner should be reversed.

BRADFORD & HOOD,
Attorneys for E. C. Atkins & Company.

Indianapolis, Indiana, November 19, 1906.

26 In the United States Patent Office.

In the Matter of the Application of E. C. Atkins & Company for Registration of Trade-mark "A.A.A." Serial No. 7998. Filed June 12, 1906.

Affidavit.

Before the Commissioner of Patents.

Petition.

I, Morris Shulte, fifty years of age, of Indianapolis, Marion County, being duly sworn, on my oath depose and say:

I am in charge of the hand saw department of the business of the Vonnegut Hardware Company, of Indianapolis, Indiana. The said Vonnegut Hardware Company buys such saws of E. C. Atkins & Company of the same place, which saws have the trade-mark "A.A.A." These saws are generally known to the trade as the "three-A" or "triple-A" saws, and are so called for by customers. Many of said customers who have been attracted by advertisements will especially examine the saws to make sure that they bear the mark "A.A.A." before they will purchase, and disregard other matter, or embel-ishments.

MAURICE SCHULTE.

STATE OF INDIANA, *County of Marion, ss:*

Subscribed and sworn to before me the undersigned, a Notary Public within and for said County and State, at Indianapolis, Indiana, this 20th day of November, 1906.

THOMAS W. McMEANS,
[NOTARIAL SEAL.] *Notary Public.*

In the United States Patent Office.

In the Matter of the Application of E. C. Atkins & Company for Registration of Trade-mark "A.A.A." Serial No. 7998. Filed June 12, 1906.

Affidavit.

Before the Commissioner of Patents.

Petition.

I, Frederick W. Hess, forty years of age, of Indianapolis, Marion County, being duly sworn, on my oath depose and say:

I am in charge of that department of the business of the Vonnegut Hardware Company, of Indianapolis, Indiana, which includes saws used for sawing metal. The said Vonnegut Hardware Company

buys such saws of E. C. Atkins & Company of the same place, which saws have the trade-mark "AAA." These saws are generally
27 known to the trade as the "three-A" or "triple-A" saws, and are so called for by customers. Many of said customers do not refer to, or appear to notice, any of the other devices or embellishments which are stamped on saws in connection with said trade-mark.

FREDERICK W. HESS.

STATE OF INDIANA, *County of Marion, ss:*

Subscribed and sworn to before me the undersigned, a Notary Public within and for said County and State, at Indianapolis, Indiana, this 20th day of November, 1906.

THOMAS W. McMEANS,
Notary Public.

[NOTARIAL SEAL.]

In the United States Patent Office.

In the Matter of the Application of E. C. Atkins & Company for Registration of Trade-mark "A.A.A." Serial No. 7998. Filed June 12, 1906.

Affidavit.

Before the Commissioner of Patents.

Petition.

I, Frank S. Bence, thirty-nine years of age, of Indianapolis, Marion County, being duly sworn, on my oath depose and say:

I am the buyer and seller of tools for the firm of Harmon & Hall, of Indianapolis, Indiana, which firm handles the saws made by E. C. Atkins & Company of the same place, bearing the "AAA" trade-mark. Said saws are known as "three-A" saws by customers, and are frequently called for by that name. The particular arrangement of the trade-mark, or matter concerning the same or used in connection therewith, is not regarded as a part of the mark.

FRANK S. BENCE.

STATE OF INDIANA, *County of Marion, ss:*

Subscribed and sworn to before me the undersigned, a Notary Public within and for said County and State, at Indianapolis, Indiana, this 20th day of November, 1906.

THOMAS W. McMEANS,
Notary Public.

[NOTARIAL SEAL.]

28 In the United States Patent Office.

Before the Commissioner of Patents.

In the Matter of the Application of E. C. Atkins & Company for Registration of Trade-mark "A.A.A." Serial No. 7998. Filed June 12, 1906.

Petition.

Affidavit.

I, Herman E. Dinkelaker, thirty-three years of age, of Indianapolis, Marion County, Indiana, being duly sworn, on my oath depose and say:

I am the manager in charge of purchases and sales of the tool department of Lilly & Stalnaker of Indianapolis, Indiana. The said Lilly & Stalnaker buys and sells saws made by E. C. Atkins & Company of the same place, which said saws bear the trade-mark "AAA." Customers generally call for these saws by that name regardless of embel-ishments or accessories. No attention is usually paid to any other inscription or matter on said saws.

HERMAN E. DINKELAKER.

STATE OF INDIANA, *County of Marion, ss:*

Subscribed and sworn to before me the undersigned, a Notary Public within and for said County and State, at Indianapolis, Indiana, this 20th day of November, 1906.

THOMAS W. McMEANS,
Notary Public.

[NOTARIAL SEAL.]

Nov. 22, 1906. S. E. T.

United States Patent Office.

Ex Parte E. C. Atkins & Company.

Trade-mark for Saws.

Petition.

Application filed June 12, 1905, No. 7998.

Messrs. Bradford & Hood for applicants.

This is a petition from the action of the examiner requiring the cancellation from the application of the description of the mark, and from his requirement that the class of merchandise shall conform to the classification established under the act approved May 4, 1906.

29 The record shows that petitioners' trade-mark was published in the Official Gazette of May 15, 1906, and that the thirty days allowed for filing oppositions expired on June 14, 1906. If the mark had then been immediately passed for registration, it would have been registered on July 10, 1906. Since the mark could not be registered before July 1, 1906, the date on which the act approved May 4, 1906, took effect, applicants were required to amend their application to conform to the provisions of said act by changing the class of merchandise to read:

"Class 20, Cutlery not included in Class 61, and edge-tools,"

and by substituting for the description of the mark which reads—

"has adopted for its use, a trade-mark of which the following is a description: The Trade-Mark consists of a symbol composed of the letters 'A A A,'"

the statement—

"has adopted for its use the trade-mark shown in the accompanying drawings."

Petitioners, at the hearing, indicated their willingness to comply with the first of the above requirements and filed an amendment substituting the title of the class suggested for that originally given.

The second requirement of the examiner was based on the act approved May 4, 1906, which amended section 1 of the act of February 20, 1905, by inserting after the words "a description of the trade-mark itself," the words "only when needed to express colors not shown in the drawing."

Petitioners contend:

"* * * that it is quite as clear that the language 'only when needed to express colors not shown in the drawing' is, in the legislative intent, *permissive* and *not* mandatory. In other words, the law means the same as though it read

a description of the trade-mark itself, *which shall be required* only when needed to express colors not shown in the drawing."

In this contention petitioners are believed to be in error. It is not thought that it was the intention of Congress in amending the statute to leave it optional with the applicant whether his application should contain a description of the trade-mark. On the contrary, I believe it was the intention that the drawing should be relied upon to disclose the mark and that a description of the mark should be permitted "only when needed to express colors not shown in the drawing." The language of the amended section appears to be clear and definite, while applicants' interpretation requires a strained construction.

It is understood that the purpose of this amendment is to make the registration definite by limiting it to the disclosure in the drawing, leaving the question of what is an immaterial variation in the mark to the courts. It thus appears that the object of the amended statute

30 is to prevent just such an apparently indefinite extension of the scope of the registered mark by a generic description, as the petitioners contend for.

In view of this interpretation of the statute, there is no error in the requirement of the examiner.

The fact that the application was filed under the former statute does not excuse petitioners from complying with the amended statute. On account of the thirty days allowed by section 6 of the act of February 20, 1906, for the filing of notices of opposition after publication in the Official Gazette, it was impossible to register petitioners' mark until after the statute went into effect on July 1, 1906, and the amended statute makes no exception of applications pending at the date it became effective.

The petition is denied.

F. I. ALLEN,
Commissioner.

January 17, 1907.

Serial No. 7998, Paper No. —.

E. E. G.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *January* 18, 1907.

In the Matter of the Application of E. C. Atkins & Company. Trade-mark for Saws. Filed June 12, 1905. No. 7998.

Petition.

SIRS: You are hereby informed that the above petition has been denied by the Commissioner. Please find enclosed herewith a copy of the decision.

By direction of the Commissioner:

Very respectfully, C. M. IRELAN, *Chief Clerk.*
F.

E. C. Atkins & Co., c/o Bradford & Hood, Stevenson Bldg., Indianapolis, Ind.

Docket Clerk,
Feb. 6, 1907,
U. S. Patent Office.

In the United States Patent Office..

In re Application of E. C. Atkins & Company, Serial No. 7998, Filed June 12, 1905, for Registration of Trade-mark "AAA" for Saws of all Kinds.

Notice of Appeal to Court of Appeals.

To the Commissioner of Patents.

SIR: You are hereby notified of an appeal to the Court of Appeals of the District of Columbia from your decision rendered on or
31 about the 17th day of January, 1907, rejecting the above entitled application and refusing the issuing of a certificate of registration for the trade-mark set forth therein.

The following are assigned as reasons of appeal:

1. That the Commissioner erred in holding that an applicant may not include in the statement forming part of an application for a certificate of registration of a trade-mark, any description of the trade-mark.

2. That the Commissioner erred in holding that the language of the amendment to the trade-mark act approved May 4, 1906, concerning the description of the trade-mark, prohibits any such description.

3. That the Commissioner erred in holding that no certificate of registration could issue upon an application filed prior to the act amendatory of the trade-mark act approved May 4, 1906, after the taking effect of said act, except in accordance with the terms of said act.

4. That the Commissioner erred in holding that where a certificate of registration was ready for issue sixteen (16) days before the taking *of* effect of the act amending the trade-mark act approved May 4, 1906, the issue of such certificate of registration should be withheld, because in ordinary course, and to suit the convenience of the Patent Office, such certificate would not ordinarily issue until July 10, 1906, after the act of May 4, 1906, took effect; although it would easily be possible to have issued said certificate before July 1, 1906, by hastening said certificate forward out of ordinary routine.

5. That the Commissioner erred in not holding that the language "only when needed to express colors not shown in the drawing" in the act approved March 4, 1906, is, in the legislative intent, permissive and not mandatory.

6. That the Commissioner erred in holding that it was impossible to register the mark in question herein until after the act approved May 4, 1906, went into effect, on July 1, 1906.

7. That the Commissioner erred in not issuing the certificate of registration prayed for in said application.

Very respectfully,

E. C. ATKINS & COMPANY,
By BRADFORD & HOOD,
Its Attorneys.

[Endorsed:] Docket clerk, U. S. Patent Office, Feb. 6, 1907. U. S. Patent Office. Copy made Feb. 8, 1907. 17,605/07.

Endorsed on cover: Commissioner of Patents. No. 424, patent appeal docket. In the matter of the application of E. C. Atkins & Company. Court of Appeals, District of Columbia. Filed Feb. 13, 1907. Henry W. Hodges, clerk.

32 WEDNESDAY, *March 13th, A. D.* 1907.

In the Matter of the Application of E. C. ATKINS & Co. No. 424.

The argument in the above entitled cause was commenced by Mr. Chester Bradford, attorney for the appellants, and was continued by Mr. Fairfax Bayard, attorney for the Commissioner of Patents, and was concluded by Mr. Chester Bradford, attorney for the appellants.

33 Patent Appeal Docket, No. 424.

In the Matter of the Application of E. C. ATKINS & COMPANY.

Opinion.

(Mr. Justice ROBB delivered the opinion of the Court:)

Appeal from a Decision of the Commissioner of Patents in a Trade Mark Case.

The material facts are as follows: Appellant applied for the registration of the trade mark "AAA" for saws, and in its application set forth that *"it has adopted for its use, a trade-mark of which the following is a description: The trade-mark consists of a symbol composed of the letters 'AAA'."*

To this description the examiner made objection, and directed the petitioner to amend its petition so that the portion above quoted would read *"has adopted for its use the trade-mark shown in the accompanying drawings."*

But for the fact that the petitioner in the hearing before the Commissioner proceeded upon the assumption that the hearing was a final adjudication of the case by the Patent Office, the fact that the Commissioner appears to have acquiesced in that assumption, and the further fact that counsel in the arguments at bar so treated the matter, we would be inclined to rule that the decision appealed from was a mere interlocutory decision from which no appeal lies to this court. In view, however, of the peculiar circumstances of this case, we will disregard matter of form and proceed to a consideration of the merits of the question involved.

The Trade-Mark Act of February 20, 1905, (33 Statutes, 724), provided *inter alia:*

"That the owner of a trade-mark * * * may obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office an application therefor in writing, specifying * * * a description of the trade-mark itself."

34 By the Act of May 4, 1906, (34 Statutes, 168), the provision for a description of the trade mark was amended so as to read:

"A description of the trade-mark itself, only when needed to express colors not shown on the drawings."

It is upon this amendment of 1906 that the Commissioner bases his decision. In it he says:

"It is understood that the purpose of this amendment is to make the registration definite by limiting it to the disclosure in the drawing, leaving the question of what is an immaterial variation in the mark to the courts. It thus appears that the object of the amended statute is to prevent just such an apparently indefinite extension of the scope of the registered mark by a generic description, as the pe-

titioners contend for." In other words, it is the opinion of the Commissioner that the law contemplates the registration of the mark actually used, and that the applicant's opinion as to the scope of the mark and his rights thereunder form no necessary part of the application.

This is a matter fairly within the discretion of the Commissioner. In such a case the court will not interfere unless there has been a gross abuse of discretion. No such abuse is here shown. No substantial right of appellant is involved since the Commissioner has not denied him registration of his trade-mark, but has merely declined to permit him to encumber his application with unnecessary and ambiguous matter. There is no claim that the descriptive matter insisted upon by appellant is "needed to express colors not shown on the drawings." The Commissioner insists that such matter is not only not needed at all, but that its inclusion in the petition would be misleading. We are not prepared to say that he is wrong.

The decision of the Commissioner of Patents is, therefore, affirmed, and the Clerk of this Court will certify this opinion to the Commissioner of Patents, according to law.

Affirmed.

35 TUESDAY, *April 2nd, A. D.* 1907.

No. 424, April Term 1907.

In the Matter of the Application of E. C. ATKINS & Co. for the Registration of Trade-Mark for Saws. Serial No. 7998.

Appeal from the Commissioner of Patents.

This cause came on to be heard on the transcript of the record from the Commissioner of Patents, and was argued by counsel. On consideration whereof, It is now here ordered and adjudged by this Court that the decision of the said Commissioner of Patents in this cause be, and the same is hereby, affirmed.

Per Mr. JUSTICE ROBB,
April 2, 1907.

36 In the Court of Appeals of the District of Columbia.

Patent Appeal Docket, No. 424.

In the Matter of the Application of E. C. ATKINS & COMPANY for Registration of Trade-mark "AAA" for Saws.

Petition for Appeal and Writ of Error to the Supreme Court of the United States.

The above-mentioned appellant and petitioner, E. C. Atkins & Company, respectfully shows that the above-entitled cause is now pending in the Court of Appeals of the District of Columbia, and

that a decision and judgment was therein rendered on or about the 2nd day of April, A. D., 1907, affirming a decision of the Commissioner of Patents, under and by virtue of an authority exercised under the United States, concerning the registration of a trade-mark; that the validity of the authority thus exercised is drawn in question; that this cause is one in which the said Court of Appeals of the District of Columbia has appellate jurisdiction over the Commissioner of Patents, and that it is a proper cause to be reviewed by the Supreme Court of the United States on appeal or writ of error.

Wherefore, the said appellant and petitioner, conceiving itself to be aggrieved by the said judgment and decision, prays that an appeal and writ of error be allowed it in the above-entitled cause, directing the Clerk of the said Court of Appeals of the District of Columbia to send the record and proceedings in said cause, with all things concerning the same, to the Supreme Court of the United States, in order that the errors complained of in the assignment of errors herewith filed by the said appellant and petitioner, may be reviewed, and, if error be found, corrected, according to the laws and customs of the United States, and thus justice be done in the premises.

And your petitioner will ever pray.

CHESTER BRADFORD,
Attorney for Appellant.

37 In the Court of Appeals of the District of Columbia.

Patent Appeal Docket, No. 424.

In the Matter of the Application of E. C. ATKINS & COMPANY for Registration of Trade-mark "AAA" for Saws.

Assignment of Errors.

The appellant and petitioner in the above entitled cause, in connection with its petition for appeal and writ of error herein, presents and files therewith its assignment of errors, as to which matters and things it says that the judgment and decision rendered herein on or about the 2nd day of April, 1907, is erroneous, to wit:

First. In holding and deciding that the decision of the Commissioner of Patents refusing to appellant the right to include in its statement forming a part of its application for a certificate of registration of its trade-mark a description of such mark, was a valid exercise of authority under the United States.

Second. In not holding and deciding that the decision of the Commissioner of Patents refusing to appellant the right to include in its statement forming a part of its application for a certificate of registration of its trade-mark a description of such mark, was not a valid exercise of authority under the United States.

Third. In not holding and deciding that the rule of practice in the Patent Office governing the practice relating to applications for

registration of trade-marks established by the decision of the Commissioner of Patents in this case, was and is an invalid exercise of authority under the United States.

Fourth. In not holding and deciding that the rule of practice in the Patent Office governing the practice relating to applications for registration of trade-marks established by the decision of the Commissioner of Patents in this case, was and is in excess of his power and authority under the statutes of the United States.

Fifth. In holding and deciding that the matter in question
38 was one fairly within the discretion of the Commissioner of Patents.

Sixth. In holding and deciding that no substantial right of appellant is involved.

Seventh. In holding and deciding that the Commissioner of Patents merely declined to permit appellant to encumber his application with unnecessary and ambiguous matter.

Eighth. In not holding and deciding that under the statute an applicant may include in his statement forming part of an application for a certificate of registration of a trade-mark, a description of such trade-mark.

Ninth. In not holding and deciding that under the statute an applicant may include in his statement forming part of an application for a certificate of registration of a trade-mark, a description of such trade-mark in other cases than "when needed to express colors not shown in the drawing."

Tenth. In not holding and deciding that the decision of the Commissioner of Patents, holding that the language of the amendment to the trade-mark act approved May 4, 1906, concerning the description of the trade-mark, prohibits any such description except when needed to express colors not shown in the drawing, was erroneous.

Eleventh. In not holding and deciding that the language "only when needed to express colors not shown in the drawing" in the act approved May 4, 1906, is, in the legislative intent, permissive and not mandatory.

Twelfth. In not holding and deciding that the inclusion in the statement forming part of an application for registration of a trade-mark of a description of such mark, is a matter within the discretion of the applicant instead of within the discretion of the Commissioner of Patents.

Thirteenth. In not holding and deciding that the decision of the Commissioner of Patents holding that no certificate of registration could issue upon an application filed prior to the act amendatory of the trade-mark act approved May 4, 1906, after the taking
39 effect of said act, except in accordance with the terms of said act, was erroneous.

Fourteenth. In not holding and deciding that the Commissioner of Patents erred in holding that where a certificate of registration was ready for issue sixteen (16) days before the taking effect of the act amending the trade-mark act approved May 4, 1906, the issue of such certificate of registration should be withheld, because in ordinary course, and to suit the convenience of the Patent Office, such

certificate would not ordinarily issue until July 10, 1906, after the act of May 4, 1906, took effect; although it would easily be possible to have issued said certificate before July 1, 1906, by hastening said certificate forward out of ordinary routine.

Fifteenth. In not holding and deciding that the decision of the Commissioner of Patents, holding that it was impossible to register the mark in question herein after the same had been found in registerable condition and passed for publication April 27, 1906, until after the act approved May 4, 1906, went into effect on July 1, 1906, was erroneous.

Sixteenth. In not holding and deciding that the Commissioner of Patents should have issued the certificate of registration of the trade-mark in question as prayed for in the application for registration of said trade-mark.

Wherefore the appellant and petitioner prays that the said judgment and decision may be reversed, and that the appellant and petitioner may have an adjudication and decision in its favor, as herein specified and prayed.

CHESTER BRADFORD,
ARTHUR M. HOOD,
Attorneys for Appellant.

(Endorsed:) Patent Appeal Docket No. 424. In the Matter of the Application of E. C. Atkins & Co. Petition for Appeal and Writ of Error to Supreme Court U. S. and Assignments of Error. Court of Appeals, District of Columbia, Filed Apr. 15, 1907. Henry W. Hodges, Clerk.

40 Court of Appeals of the District of Columbia, April Term, 1907.

No. 424, Patent Appeal Docket.

In the Matter of the Application of E. C. ATKINS & Co.

The petition for the allowance of an appeal and writ of error to the Supreme Court of the United States in the above entitled cause is founded on the decisions of the Supreme Court of the United States in the case of U. S. *ex rel.* Steinmetz *vs.* Allen, 192 U. S., 543, and U. S. *ex rel.* Lowry *vs.* Allen, 203 U. S., 476. Entertaining doubt as to the right of the petitioners, we regard it as our duty to resolve that doubt in their favor. It is, therefore, by the Court now here ordered that said appeal and writ of error be, and the same are hereby, allowed, and the bond for costs on said appeal and writ of error is hereby fixed at the sum of three hundred dollars, or a cash deposit of one hundred dollars may be made with the Clerk in lieu of bond.

And it is further ordered that the opinion and judgment in said cause be withheld until further order of Court.

Per MR. CHIEF JUSTICE SHEPARD.
April 16, 1907.

(Endorsed:) Patent Appeal Docket No. 424. Court of Appeals of the District of Columbia. Order allowing appeal and writ of Error to Supreme Court, U. S., and fixing bond for costs at $300, or deposit in lieu of bond at $100 and staying opinion and judgment until further order. Court of Appeals, District of Columbia, filed April 16, 1907. Henry W. Hodges, Clerk.

41 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the Honorable the Justices of the Court of Appeals of the District of Columbia, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals before you, or some of you, in the matter of the Application of E. C. Atkins & Company a manifest error hath happened, to the great damage of the said E. C. Atkins & Company as by their complaint appears. We being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court at Washington, within 30 days from the date hereof, that the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right, and according to the laws and customs of the United States should be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 16th day of April, in the year of our Lord one thousand nine hundred and seven.

[Seal Court of Appeals, District of Columbia.]

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

Allowed by

——— ———.

42 *Memorandum.*

May 6, 1907.—One hundred dollars deposited with the Clerk in lieu of bond.

43 UNITED STATES OF AMERICA; *ss:*

To F. I. Allen, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date hereof, pursuant to an order allowing an appeal, filed in the Clerk's Office of the Court of Appeals of the District of Columbia, wherein E. C. Atkins & Company is appellant and you are appellee, to show cause, if any there be, why the decree rendered against the appellant, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable Seth Shepard, Chief Justice of the Court of Appeals of the District of Columbia, this 6th day of May, in the year of our Lord one thousand nine hundred and seven.

SETH SHEPARD,
Chief Justice of the Court of Appeals of the District of Columbia.

Service accepted this 6th day of May 1907.

F. I. ALLEN,
Commissioner of Patents.

44 UNITED STATES OF AMERICA, *ss:*

To F. I. Allen, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date hereof, pursuant to a writ of error, filed in the Clerk's Office of the Court of Appeals of the District of Columbia, In the matter of the Application of E. C. Atkins & Company, wherein E. C. Atkins & Company is plaintiff in error, and you are defendant in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable Seth Shepard, Chief Justice of the Court of Appeals of the District of Columbia, this 6th day of May, in the year of our Lord one thousand nine hundred and seven.

SETH SHEPARD,
Chief Justice of the Court of Appeals of the District of Columbia.

Service accepted this 6th day of May, 1907.

F. I. ALLEN,
Commissioner of Patents.

45 Court of Appeals of the District of Columbia.

I, Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages numbered from 1 to 44 inclusive, contain a true copy of the transcript of record and proceedings of said Court of Appeals in the matter of the Application of E. C. Atkins & Company, No. 424, Patent Appeal Docket, April Term, 1907, as the same remain upon the files of said Court of Appeals.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the City of Washington, this 6th day of May A. D. 1907.

[Seal Court of Appeals, District of Columbia.]

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

Endorsed on cover: File No. 20,719. District of Columbia Court of Appeals. Term No. 317. E. C. Atkins & Company, appellant and plaintiff in error, *vs.* E. B. Moore, Commissioner of Patents. Filed May 15th, 1907. File No. 20,719.

FILED.
DEC 12 1908
JAMES H. McKENNEY,
CLERK.

IN THE

Supreme Court of the United States

APPEAL FROM AND IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

E. C. ATKINS & COMPANY,
Appellant and Plaintiff in Error,
vs.
E. B. MOORE,
Commissioner of Patents.

October Term, 1908.
No. 86.

BRIEF FOR APPELLANT AND PLAINTIFF IN ERROR.

CHESTER BRADFORD,
ARTHUR M. HOOD,
Attorneys for E. C. Atkins & Company,
SUITE 1285 STATE LIFE BUILDING,
INDIANAPOLIS, INDIANA.

E. W. BRADFORD,
Of Counsel.

In the Supreme Court of the United States

APPEAL FROM AND IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

E. C. ATKINS & COMPANY,
Appellant and Plaintiff in Error,
vs.
E. B. MOORE,
Commissioner of Patents.

October Term, 1908.
No. 86.

BRIEF FOR APPELLANT AND PLAINTIFF IN ERROR.

STATEMENT OF THE CASE.

May it Please the Court:

This case comes here under the clause of Section 8 of the Act of February 9, 1893 (Chap. 74, U. S. Comp. Stat. 1901, p. 573; Supplement, R. S. 2, p. 79), which gives an appeal to this Court from the final judgment or decree of the Court of Appeals of the District of Columbia in cases in which there is drawn in question the validity of "an authority exercised under the United States."

U. S. ex rel Steinmetz vs. *Allen, Commissioner,* 192 U. S. 543; 48 L. Ed. 555.

It involves the construction of Section 1 of the Act of Congress of February 20, 1905, relating to Trade-Marks, as amended by the Act of May 4, 1906.

The particular question presented is whether or not the Commissioner in exercising the authority conferred upon him by said Acts may deny to an applicant the right to state, in the statement forming part of his application, of what his Trade-Mark consists. In other words, whether the denial of that right is a valid or invalid exercise of his authority.

Incidentally, it calls in question the right of the Commissioner, the trade-mark being in condition to be registered prior to July 1, 1906, when the amendment to the Trade-Mark Statute enacted by the Act of May 4, 1906, took effect, to withhold such registration until a date subsequent to the taking effect of said Act.

We assert in and by our formal

ASSIGNMENT OF ERRORS

(Rec. pp. 36-38) that the Court of Appeals of the District of Columbia erred:

First. In holding and deciding that the decision of the Commissioner of Patents refusing to appellant the right to include in its statement forming a part of its application for a certificate of registration of its trade-mark a description of such mark, was a valid exercise of authority under the United States.

Second. In not holding and deciding that the decision of the Commissioner of Patents refusing to appellant the right to include in its statement forming a part of its ap-

plication for a certificate of registration of its trade-mark a description of such mark, was not a valid exercise of authority under the United States.

Third. In not holding and deciding that the rule of practice in the Patent Office governing the practice relating to applications for registration of trade-marks established by the decision of the Commissioner of Patents in this case, was and is an invalid exercise of authority under the United States.

Fourth. In not holding and deciding that the rule of practice in the Patent Office governing the practice relating to applications for registration of trade-marks established by the decision of the Commissioner of Patents in this case, was and is in excess of his power and authority under the statutes of the United States.

Fifth. In holding and deciding that the matter in question was one fairly within the discretion of the Commissioner of Patents.

Sixth. In holding and deciding that no substantial right of appellant is involved.

Seventh. In holding and deciding that the Commissioner of Patents merely declined to permit appellant to encumber his application with unnecessary and ambiguous matter.

Eighth. In not holding and deciding that under the statute an applicant may include in his statement forming part of an application for a certificate of registration of a trade-mark, a description of such trade-mark.

Ninth. In not holding and deciding that under the statute an applicant may include in his statement forming part of an application for a certificate of registration of

a trade-mark, a description of such trade-mark in other cases than "when needed to express colors not shown in the drawing."

Tenth. In not holding and deciding that the decision of the Commissioner of Patents, holding that the language of the amendment to the trade-mark act approved May 4, 1906, concerning the description of the trade-mark, prohibits any such description except when needed to express colors not shown in the drawings, was erroneous.

Eleventh. In not holding and deciding that the language "only when needed to express colors not shown in the drawing" in the Act approved May 4, 1906, is, in the legislative intent, permissive and not mandatory.

Twelfth. In not holding and deciding that the inclusion in the statement forming part of an application for registration of a trade-mark of a description of such mark, is a matter within the discretion of the applicant instead of within the discretion of the Commissioner of Patents.

Thirteenth. In not holding and deciding that the decision of the Commissioner of Patents holding that no certificate of registration could issue upon an application filed prior to the act amendatory of the trade-mark act approved May 4, 1906, after the taking effect of said act, except in accordance with the terms of said act, was erroneous.

Fourteenth. In not holding and deciding that the Commissioner of Patents erred in holding that where a certificate of registration was ready for issue sixteen (16) days before the taking effect of the act amending the trade-mark act approved May 4, 1906, the issue of such certificate of registration should be withheld, because in ordi-

nary course, and to suit the convenience of the Patent Office, such certificate would not ordinarily issue until July 10, 1906, after the act of May 4, 1906, took effect; although it would easily be possible to have issued said certificate before July 1, 1906, by hastening said certificate forward out of ordinary routine.

Fifteenth. In not holding and deciding that the decision of the Commissioner of Patents, holding that it was impossible to register the mark in question herein after the same had been found in registerable condition and passed for publication April 27, 1906, until after the act approved May 4, 1906, went into effect on July 1, 1906, was erroneous.

Sixteenth. In not holding and deciding that the Commissioner of Patents should have issued the certificate of registration of the trade-mark in question as prayed for in the application for registration of said trade-mark.

THE TRADE-MARK INVOLVED.

In order that the Court may have before it at the outset the subject-matter of the controversy, we print herewith a cut showing the form (Rec. p. 3) in which the Trade-Mark in question is most generally used:

Other forms in which said Trade-Mark is used were exhibited to the Commissioner and to the Court of Appeals at the hearings, and will be before this Court at the hearing in this case.

For convenience, the "Statement" forming part of said application for registration as it read at the time of the petition to the Commissioner (Rec. pp. 4 and 6) is here quoted, as follows:

STATEMENT.

To all whom it may concern:

Be it known, That E. C. ATKINS & COMPANY, a corporation duly organized under the laws of the State of Indiana, and located in Indianapolis, County of Marion, State of Indiana, and doing business at Nos. 402-410 South Illinois Street, in said city, and also in New York, N. Y., Memphis, Tenn., Atlanta, Ga., Minneapolis, Minn., Portland, Oregon, Seattle, Wash., San Francisco, Cal., Chicago, Ill., and Toronto, Canada, has adopted for its use, a trade-mark, of which the following is a description:

The trade-mark consists of a symbol composed of the letters "AAA."

The trade-mark has been continuously used in the business of this corporation, and in the business of its predecessors, the firm of E. C. Atkins & Co., from which it derives its title, since about the month of June, 1884.

The class of goods to which the trade-mark is appropriated is tools and cutting instruments, and the particular description of goods comprised in said class upon which said trade-mark is used is saws of all kinds.

The trade-mark is usually displayed on the goods, by etching, stamping or otherwise marking the

same upon the blade of the saw, and by inscribing same upon the packages containing such saws.

**The trade-mark is shown with the letters arranged in the form of a monogram.*

E. C. ATKINS & COMPANY,
By MERRITT A. POTTER, *Treasurer.*

In response to the objections of the Patent Office, applicant has offered to amend (see Rec. p. 24, and tender of amendment on p. 25) so that said "Statement" would read as follows:

STATEMENT.

To all whom it may concern:

Be it known, That E. C. ATKINS & COMPANY, a corporation duly organized under the laws of the State of Indiana, and located in Indianapolis, County of Marion, State of Indiana, and doing business at Nos. 402-410 South Illinois Street in said city, and also in New York, N. Y., Memphis, Tenn., Atlanta, Ga., Minneapolis, Minn., Portland, Oregon, Seattle, Wash., San Francisco, Cal., Chicago, Ill., and Toronto, Canada, has adopted for its use a trade-mark which is illustrated in the accompanying drawing, and which consists of the letters "AAA."

The trade-mark has been continuously used in the business of this corporation and in the business of its predecessors, the firm of E. C. Atkins & Co., from which it derives its title, since about the month of June, 1884.

The class of goods to which the trade-mark is appropriated is class 20, cutlery not included in class 61, and edge tools, and the particular description of goods comprised in said class upon which said trade-mark is used is saws of all kinds.

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*Inserted by Amendment. See Record, p. 6.

The trade-mark is usually displayed on the goods by etching, stamping or otherwise marking the same upon the blade of the saw, and by inscribing the same upon the packages containing such saws.

E. C. ATKINS & COMPANY,
By MERRITT A. POTTER, *Treasurer.*

The Commissioner treated the case as thus amended at the hearing before him, and it may be so considered.

The application in question was filed June 12, 1905. After sundry actions by the Examiner of Trade-Marks, and the amendment to the statement noted, a petition (Rec. pp. 9-10) was taken to the Commissioner, who, on April 20, 1906 (Rec. p. 13), overruled the Examiner and granted the petition.

Seven days thereafter, on April 27, 1906, the Examiner of Trade-Marks passed the mark for publication, but withheld actual publication until May 15, 1906 (Rec. p. 14).

The thirty days' publication (even after these delays) expired June 14, 1906.

Thereafter, on June 21, 1906, the Examiner wrote a letter (Rec. pp. 14-15) requiring that the Statement should be amended to conform to his interpretation of the requirements of an amendment to the Trade-Mark Statute then recently enacted, and which was presently, on July 1, 1906, to take effect.

Applicant declined (Rec. pp. 15-16) to make the change; the Examiner (Rec. p. 16) insisted upon his requirement, and the applicant thereupon (Rec. pp. 17-18) took the petition, which resulted in the decision (Rec. pp. 30-32) from which the appeal was taken.

The assignments of error all relate to the two principal matters or grounds stated at the outset.

ARGUMENT.

We will take up the second stated of these matters first.

WAS IT IMPOSSIBLE TO ISSUE THIS CERTIFICATE BEFORE JULY 1, 1906?

The Commissioner, at the conclusion of his opinion (Rec. p. 32) denying the petition, said:

> On account of the thirty days allowed by section 6 of the act of February 20, 1906, for the filing of notices of opposition after publication in the Official Gazette, it was *impossible* to register petitioners' mark until after the statute went into effect on July 1, 1906, and the amended statute makes no exception of applications pending at the date it became effective.

In this holding, the Commissioner of Patents left out of consideration a number of facts. There was, as a matter of fact, abundant time, after the Commissioner's decision of April 20, 1906, to have issued the certificate before July 1, 1906, if the Patent Office officials had proceeded promptly.

1. There was a delay of *seven days* between the date of the said Commissioner's decision, and the date when the Examiner passed the application for publication.

2. There was a delay of *eighteen days* between the date when the application was finally passed for publication, and the date when publication was actually made.

3. The thirty days (even after the delay stated) expired June 14, 1906. It was *possible* to issue the certificate before July 1, 1906, after that date. It is true that the common practice (taking all the time occupied by ordinary routine) would result, where an application was allowed

June 14, 1906, in the issue of the certificate July 3, 1906; or, where an application was allowed between June 15th and June 21st, 1906, in the issue of the certificate on July 10, 1906. There is, however, no law requiring the taking of this period of time. It is a mere matter of routine.

As already stated, the Examiner delayed *seven days* from the date of the decision of the Commissioner before passing this application for publication, and delayed the actual publication *eighteen days* more, making a total of *twenty-five days* after the date when the Commissioner had decided the application to be in proper form.

The thirty days' publication, even after these delays, expired June 14, 1906. If passed for registration that day, the trade-mark would have been registered in due course, taking all the time usually taken by the routine of the Patent Office, July 3, 1906. If passed for registration between June 15th and June 21st, 1906, it would have been registered July 10, 1906. This is the date claimed by the Examiner in his statement (Rec. pp. 19-21), so that, at the latest, the date of registration was *only ten days* beyond the date when it might have been registered under the law as it stood before amendment, while the Examiner, as we have already seen, had delayed the publication *twenty-five days* beyond the date of the decision of the Commissioner overruling his previous action. As the Official Gazette is published weekly, this was *effectively* a delay of twenty-one days, or three weeks. So that there was a delay of more than double the longest time claimed by the Examiner as the time beyond the date when it might have properly been registered under the law as it stood before the amendment went into effect on July 1, 1906.

It is plain, therefore, even were the Examiner's and the Commissioner's contention correct, that the failure to register the Mark previous to the taking effect of the amendment to the law was wholly their own fault.

And it is equally plain that it would have been easily possible to have registered the mark between June 14 and June 30, if the Patent Office was so disposed. The period of delay which would carry the registration to July 3—or July 10—is merely a matter of convenience of the Patent Office, and is not required by the law. In such a case, where the previous delays were wholly the fault of the officials, it would seem that they should depart from routine, and issue the certificate within the time, if that were necessary.

It is clear, therefore, that the Commissioner erred in his holding that it was impossible to register petitioner's Trade-mark until after the amendment to the Trade-mark statute went into effect, on July 1, 1906.

The question arising out of these proceedings of the Commissioner is not presented with the same degree of confidence that the remaining question is; but, it being clear that applicant has suffered a wrong by the stubbornly willful and unlawful position taken by the Commissioner of Patents and his Examiner of Trade-Marks, there should, it seems, be some remedy available. If no other remedy is seen, it is suggested that perhaps this Court may order a Certificate of Registration of this Trade-mark issued *nunc pro tunc* as of the date when it should have been originally issued, prior to the taking effect of the amendment of the Statute on July 1, 1906.

For so serious a wrong as will result from the action complained of (should the Commissioner's construction of the law be sustained) there ought certainly to be some effective remedy.

Of course, if, as we trust will be the case, the Court shall sustain appellant's other contention, and the description of the Trade-mark be thus permitted, this point will become important and may be disregarded.

THE COMMISSIONER MISINTERPRETED THE LAW.

We now come to the other branch of our contention, and to this we earnestly request the careful attention of the Court, as it involves the construction of section 1 of the Trade-mark act, as amended, which reads as follows:

> Sec. 1. That the owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States, or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated; a description of the trade-mark itself, *only when needed to express colors not shown in the drawing*, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used. With this

> statement shall be filed a drawing of the trade-mark, signed by the applicant, or his attorney, and such number of specimens of the trade-mark, as actually used, as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this Act and such regulations as may be prescribed by the Commissioner of Patents.

The pertinent portion of this section, to which we invite particular consideration, reads as follows:

> a description of the trade-mark itself, only when needed to express colors not shown in the drawing.

We contend, as we contended before the Commissioner, and the lower Court, that this language "only when needed to express colors not shown in the drawing," is, in the legislative intent, *permissive* and *not* mandatory. In other words, the law means the same as though it read

> a description of the trade-mark itself, *which shall be required* only when needed to express colors not shown in the drawing.

If the suggested words "which shall be required" had actually been included in the law, there could have been no controversy on the subject; but that the law, as it reads, permits (if it does not require) these words to be understood, seems clear.

We contend, therefore, that even under the law as it now reads, and wholly irrespective of applicant's rights because of having made application before the law was amended, under which application their right to registration was fully settled and determined, and under which the registration might have been effected except for delays which were the fault of the Patent Office, that applicant has the right,

if it so elects, to appropriately describe the mark in the Statement.

The Statement which applicant has proposed and tendered to the Patent Office is precisely in accordance with the requirement of the Examiner and of the Commissioner, except that the descriptive portion thereof reads:

> has adopted for its use *a* trade-mark *which is illustrated* in the accompanying drawing, *and which consists of the letters AAA.*

instead of reading:

> has adopted for its use *the* trade-mark *shown* in the accompanying drawing.

In other words, by cancelling the phrase "and which consists of the letters AAA," the requirements of the Patent Office would be substantially, although not exactly, complied with.

The drawing (between pages 22 and 23 of record) shows that the trade-mark consists of these three letters.

Some of the various uses which have been made of this mark are illustrated in the examples which were before the Commissioner on the petition (Rec. pp. 17-18), and which will be exhibited to the Court. If the description required by the Examiner, reading "has adopted for its use *the* Trade-mark shown in the accompanying drawing," is submitted to, there is at least a possibility that it would be held that the trade-mark was restricted to the peculiar arrangement and style shown in the drawing. This, it may be said, while the most common form and arrangement, is by no means the only form in which this mark is used.

This trade-mark has now been used for more than twenty-four years. It is used upon literally hundreds of

thousands of saws annually. As shown by the Declaration (Rec. pp. 4-5) such saws are sold and known over almost the entire civilized globe. It is the most important piece of trade-mark property which this applicant owns. It is believed to be its right to appropriately describe that mark in the statement forming part of the certificate of registration. To deny that right, is to deny or endanger a property interest of great magnitude.

The trade-mark statute, it is respectfully submitted, was enacted to benefit, and not to damage, the owners of trade-mark property. It is to be fairly, at least, and we believe liberally, construed. If there is reasonable doubt we think it ought to be resolved in favor of the applicant.

But we do not see how there is even a reasonable doubt. The Congress could have had no object in *prohibiting* an applicant from appropriately describing his mark. The reasonable interpretation is, therefore, that the legislative intent was to reduce rather than increase applicants' burdens, and to *permit* them to omit descriptions of their trade-marks if they saw fit.

The decision of the Court of Appeals in the *Standard Underground Cable Co. case* is, we believe, written upon the proper theory. In that case the Court said:

> When an appellant presents his trade-mark for registration under the act approved February 20, 1905, *who is to determine* of what the mark consists? If, as in the present case, the mark is impressed upon a label, and, in addition to the matter claimed as the trade-mark by an applicant, certain *accessories* are shown, is the power vested in the Commissioner of Patents to say to applicant, "You must describe or show your mark not only as consisting of what you say it is, but also you must in-

clude such portion of the accessories, or parts of the label, as I think are a material portion of the mark, although you may think otherwise?" The power is an autocratic one, and its possession by the Commissioner of Patents can not be presumed, but must, we think, be set forth in the Statute with reasonable clearness. We must bear in mind that the trade-mark act of 1905 does not create trade-mark rights. It provides for their registry. The Courts are to determine the scope of any trade-mark, registered or unregistered. If the holding of the Commissioner of Patents as to what is an applicant's real trade-mark proves to be erroneous, *who suffers therefrom?* Surely not the Patent Office or its officials; usually the *registrant* and those holding under him. As the *burden* is his, why should not the *election* be his? If he errs he pays the penalty.

. . . . . .

We repeat that we do not think Congress intended to confer upon the Commissioner of Patents authority to say to an applicant how much or how little of the embellishments appear, in connection with what may be called **the essential feature** of a trade-mark, as an actual part of the trade-mark. Rather do we think that *this right of selection and designation rests with the applicant.* No general rule can possibly be applied, and where this is the case it is unwise to attempt to exercise a power not expressly vested in an executive officer.

In re, *Standard Underground Cable Co.*, 27 App. D. C. 320.

THE REASON FOR APPLICANT'S CONTENTION.

The mark being (and appropriately so) shown in the ornamental form in which it is most commonly employed, we think if applicant is required to say in its statement that its trade-mark consists of *"the* trade-mark shown in the accompanying drawing," that there is danger that it

might some time be held that the "three A's" used in a different arrangement, or in different type, might not be *"the"* particular mark so "shown." At all events, applicant does not wish to take such chances, and it knows of no good reason why it should do so, as it believes that the law permits it to avoid this danger by stating, also, as a part of its Statement, in what its trade-mark consists.

The trade-mark is one which is widely known as the "three-A" or "triple-A" mark. It is used in varying forms. The goods are called for in this manner by customers. This is clearly shown by the affidavits of MAURICE SCHULTE, FREDERICK W. HESS, FRANK S. BENCE and HERMAN E. DINKELAKER, which were submitted to the Commissioner of Patents, and are found on pages 28-30 of the record.

It is under such circumstances, and owing to such conditions, that applicant declines to take any step which might have the effect of limiting its trade-mark rights.

THE INTENTION OF THE TRADE-MARK STATUTES.

In a consideration of this question it may be well, first, to recall the nature of the subject.

Trade-marks are not created by statute. The statute under consideration *does not pretend to create any new right* in trade-marks. It merely prescribes how and where they may, at the option of the owner, be registered; and how the rights of trade-mark owners who have registered them may be enforced.

It is highly improbable, we believe, that Congress should have intended that the rights of a trade-mark owner should

be *narrowed* as a condition of having this registration effected. There is no conceivable reason why Congress should have any such object in view.

In considering the object of this legislation, we may profitably refer to the condition which existed under preceding statutes:

Prior to the taking effect of the Act approved February 20, 1905, owners of trade-marks could *only* register them in cases where the marks were "used in commerce with foreign nations or with Indian tribes." The great, and significant, change made by the enactment of the statute of February 20, 1905, was the one which enabled owners of trade-marks who used them "among the several States," as well as those who used them only in commerce with "foreign nations or with Indian tribes," to secure registration, and the other benefits given by the statute. The purpose, therefore, was to **extend** the benefits of this statutory registration to a large class who had theretofore been deprived of such benefits.

Like all new statutes, a few months of practical experience demonstrated that it was susceptible of some improvement. This was especially so under the harsh and illiberal construction placed upon it by the then Commissioner of Patents, and his Examiner of Trade-marks. When Congress reassembled there was a demand for correction. There had been a continual turmoil of contest between attorneys and the Examiner of Trade-marks concerning the proper description of the essential features of such trade-mark. A good example of what applicants had to contend with is found in the *Standard Underground Cable Company case,* to which attention has already been called.

Then the phrase "merchandise of the same descriptive properties" used in the act as originally passed was another source of contention—the Examiner of Trade-marks being especially illiberal in determining what things were and what were not "of the same descriptive properties."

In order to avoid the first trouble, and *enable applicants to omit* from their "Statements" *limiting* descriptive matter likely to have a narrowing effect, such as the Patent Office officials were in the habit of insisting upon, the words "only when needed to express colors not shown in the drawing" were inserted in section 1, in the phrase beginning "a description of the trade-mark itself," such description having, up to that time, been an express and positive requirement of the statute. The present requirement, therefore, is "a description of the trade-mark itself, only when needed to express colors not shown in the drawing."

The other amendments enacted by the act approved May 4, 1906, do not relate to the present discussion and will not, therefore, be further referred to.

WHAT DID CONGRESS MEAN TO ACCOMPLISH?

Now what was the *legislative intent* in inserting these words by amendment in this section of the statute? Was it the purpose to *restrict* and *hamper* applicants, or was it the purpose to *liberalize* the statute for their benefit?

It is to be remembered that "a description of the trade-mark itself" prior to this amended act was a *positive* "requirement" of the statute, applying to *all* cases. Is it reasonable to believe that Congress meant, by inserting these

words, to transform a positive *requirement* into a positive *prohibition?* We submit:

FIRST. That it is most unreasonable to ascribe any such intent to the legislative body. There was no object to be accomplished.

SECOND. It would be in the direction of destroying valuable property rights; and that in a class of property which legislatures and courts from time immemorial have regarded with high favor.

THIRD. While the language must be conceded to be somewhat ambiguous—because, if it were not, the present contest could not have arisen—still we believe the most natural meaning is that which we have ascribed to it.

In order to read this statute clearly, let us omit the intervening clauses of the requirements, when the statute would read as follows:

> "The owner of a trade-mark . . may obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office . . . . . .
> . . . . . .
> a description of the trade-mark itself, only when needed to express colors not shown in the drawing, and a statement of the mode in which the same is applied and affixed to the goods, and the length of time during which the trade-mark has been used."

It seems difficult to construe this language as it has been construed by the Commissioner and his Examiner of Trade-marks; and it is certainly impossible to discover any reason why it should be so construed.

Several things, including

> "a description of the mark itself,"

were made positive requirements by the original statute.

Congress by an amendment, inserted the words

> *only when needed to express colors not shown in the drawing,*

which had the effect, we contend, of *excepting* most cases from this positive requirement, but by no means *prohibiting* such description. The phrase, it will be noticed, is between commas, and thus parenthetical, and we contend that it means the same as if it read:

> *only required when needed to express colors not shown in the drawing,*

or

> *only necessary when needed to express colors not shown in the drawing,*

or

> *which requirement will only be enforced when such description is needed to express colors not shown in the drawing,*

The word "only" relates back to "requirements" and the phrase

> a description of the trade-mark itself, only when needed to express colors not shown in the drawing,

is not at all the equivalent of such a phrase as

> a description of the trade-mark itself which shall not be made except when neded to express colors not shown in the drawing,

or such as the still plainer and more direct phrase

> no description of the trade-mark shall be embodied in the statement unless needed to express colors not shown in the drawing,

or a phrase of similar import which could have been used, and which, if used, would undoubtedly have meant what the Commissioner and the Examiner of Trade-marks insist that the present phrase means.

And the case ought to be a plain one when this Court would be ready to endorse the contention that Congress

has been guilty of the confusion of ideas, and lack of power of expression, involved in introducing into the midst of a series of positive **requirements** a positive **prohibition**, in defiance of ordinary grammatical usage, and prevailing customs of speech.

If Congress had meant to take away the right of applicants to include a description of their marks in the Statements, it certainly had the ability to say so plainly, and not leave us to the doubtful condition of reasonless forced interpretation.

Suppose that Congress, instead of inserting the qualifying or excepting phrase, had *stricken out* the words "a description of the trade-mark itself" altogether, so that the statute would have been silent on the subject. Could it then have been contended that a description was prohibited? And where Congress says by its enactment that it *requires* a description "only" in *certain* cases, is an applicant to be prohibited from furnishing a description in *other* cases, when, if Congress had omitted the "requirement" altogether, he would have been at liberty to insert such description, if appropriate, at will?

In other words, is an applicant *prohibited* from voluntarily doing a thing in *some* cases which he is *required* to do in *other* cases, when if there was no requirement at all he might do or omit to do that thing in all cases according to his own pleasure?

The only object of the amendment appears to have been to limit the "requirement" of description in the "Statement" to cases "when needed to express colors not shown in the drawing," making such description NECESSARY only in such cases, and leaving it OPTIONAL with applicants whether or

not description of the marks should be furnished in other cases. If Congress had any other object, it is difficult to understand why, or what it was. The effect, we contend, was to OMIT a "requirement" theretofore made a positive prerequisite to registration. Omission to require the doing of a thing is not a prohibition of it.

"Remedial statutes must be construed with reference to the evils sought to be remedied."

The Court of Appeals of the District of Columbia, in reference to the ruling of the Commissioner of Patent, said:

> "This is a matter fairly within the *discretion* of the Commissioner."

This statement seems to be obviously unsound. The statute either does or does not prohibit the use of a description of a trade-mark in the "statement" forming part of the application for registration. There is no "discretion" involved. The Commissioner cannot, at his "discretion" enforce or fail to enforce the statutory requirements. If description is prohibited, it is the Commissioner's duty to enforce that prohibition. If it is not prohibited then it is equally his duty to permit suitable and proper description. We contend that the statute does not prohibit description, and that, therefore, we had a right to properly describe the mark. The Commissioner raised no objection to the *form* of description used, nor did he criticise it in any way. He simply excluded it *in toto*. It, therefore appears to be admittedly a proper description, if any description at all is admissible.

The sole question therefore, in this branch of the case, is whether or not the statute prohibits a description of a Trade-

Mark in the Statement forming part of the Application for Registration.

We think that the decision appealed from, which affirmed the decision of the Commissioner of Patents denying applicant the right to describe its Trade-Mark in such Statement, was clearly wrong, and that said decision should be reversed.

Respectfully submitted,

CHESTER BRADFORD,

ARTHUR M. HOOD,

For E. C. Atkins & Company.

Indianapolis, Indiana, November 10, 1908.

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IN THE

Supreme Court of the United States

APPEAL FROM AND IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

E. C. ATKINS & COMPANY,
Appellant and Plaintiff in Error,
v.
E. B. MOORE,
Commissioner of Patents.

October Term, 1908.
No. 86.

Supplemental Brief for Appellant and Plaintiff in Error Upon the Question of Jurisdiction, Differentiating from the *Gaines* Case.

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No. 86.

Supplemental Brief Upon the Question of Jurisdiction, Differentiating from Gaines & Company v. Knecht & Son.

May it please the Court:

Under the leave obtained, I shall endeavor to differentiate the case at bar, from the case of *Gaines & Co.* v. *Knecht & Son* (No. 52 of the present term), and, incidentally, from the case of *Frasch* v. *Moore*, 211 U. S. 1, upon the authority of which the *Gaines* case was dismissed for want of jurisdiction.

I consider the differences fundamental.

In stating these differences, I shall quote freely from pertinent sources, and italics in the quotations will be used where they seem to aid the point sought to be made.

The statute under which this case can come here, if at all, is the act of February 9, 1893, "to establish a Court of Appeals for the District of Columbia, and for other purposes," being Chap. 74 U. S. Comp. Stat. 1901, p. 573; Supplement R. S., Vol. 2, p. 79; 27 Stat. at Large 436; 4 Fed. Stat. Ann. 466, and section 8 of which reads as follows:

> Sec. 8. That any *final judgment or decree* of the said court of appeals may be re-examined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in all causes in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, in the same manner and under the same regulations as heretofore provided for in cases of writs of error on judgment or appeals from decrees rendered in the supreme court of the District of Columbia;
>
> and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or *in which is drawn in question the validity of* a treaty or statute of or *an authority exercised under the United States.*

In order that a case may be brought here from the Court of Appeals of the District of Columbia, two conditions, therefore, must concurrently exist:

(1) There must be a *final* judgment or decree, and

(2) A *subject-matter* defined by the statute must exist.

These conditions exist in the case at bar. Did they exist in the cases of *Gaines* v. *Knecht*, and *Frasch* v. *Moore*?

The record in the *Gaines* case shows that it was an "opposition" proceeding brought under section 6 of the Trade-mark Act of February 20, 1905, which, among other things, provides:

> "Any person who believes he will be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered," etc.

After the notice of opposition was filed, there was an attempt made to include therein a contention that the entire act under which said proceeding was brought was unconstitutional and void. (*Gaines* Record, p. 17.)

When this matter came before the Commissioner of Patents, (*Gaines* Record, p. 22) the Commissioner of Patents ruled (we quote his entire ruling for convenience) as follows:

> "In regard to the second question, it is not believed that this office would be justified in refusing to register a trade-mark as directed by the act of Congress dated February 20, 1905, even if it were to conclude that marks registered under that act were of no legal effect and void. After this office has concluded that the applicant is the owner of the trade-mark disclosed in his application, and that it is not one of those marks the registration of which is prohibited, it be-

comes the ministerial duty of the office to register the mark under the act of February 20, 1905. Such registration does not create a property right in the applicant, nor take away the property right of another, but is a mere record of the applicant's claim of title. The real right of the applicant is subject to investigation and determination in suits brought in the courts subsequently, either by or against him. The question whether that registration constitutes *prima facie* evidence of ownership may call for a determination as to the constitutionality of the law providing for registration. It is believed that this office should leave the determination of this question to the courts in the regular way.

The Supreme Court of the District of Columbia in the case of *Schumacher* v. *Marble*, 3 Mackey 32, said:

"'We do not think it lies in the mouth of a government official to call in question the constitutionality of a law directing him to perform a purely ministerial duty. If the question was raised between other parties, as for instance, in a suit for infringement in the use of a label, and the constitutional rights of the parties were involved in it, that is to say, whether one man was prohibited from using it because another man had registered it as a label, the argument might be pertinent, but we do not think it is a question which can be raised here.'"

When the case came to the Court of Appeals of the District of Columbia, that court (*Gaines* Record, pp. 25-28) reviewed all the contentions fully, affirming the decision of the Commissioner, and saying (p. 26), among other things:

"If the act is void it may be pertinently inquired, How can the opponent make use of the act for the purposes of opposition? A void act must be void as to the opponent no less than as to the applicant. It cannot be that an act utterly void because dealing with a subject-matter upon which the legislature had no right to speak nevertheless provides the procedure upon which the opponent may challenge the validity of the act itself. The opponent has no standing whatever as a party to this proceeding except by the provisions of the very act which he says is entirely void. Therefore, his objection, if true, cuts the ground from under his own feet.

But there is another reason why the opponent cannot raise the question. Courts sit only to protect and vindicate rights of person or property. It will not be claimed that any right of person is in danger here. Neither is any right of property infringed upon or threatened if the act is unconstitutional and void. What harm can it do the opponent to have another trade-mark registered under an act which is void upon its face? *The certificate of registration must*

be read in connection with the act and derives its whole validity from the act, and if the act itself is void, so is the certificate void upon its face.

And further (p. 27) saying:

"When some case shall arise in which rights of person or property must be affected by the decision, it will become necessary to consider the question now attempted to be raised; but to pass upon it now would be to decide a question of theory alone, and this is not the province of a court. Clough v. Curtis, 134 U. S. 361, 372; Chicago R. R. Co. v. William, 143 U. S. 339, 345; California v. San Pablo R. R. Co., 149 U. S. 308, 314; Brown v. Root, 18 App. D. C. 239, 243. The act purports to provide means for the protection and enforcement of rights acquired by complying with its provisions. *When any of these means are sought to be turned against the opponent he will, if his contention is sound, have a perfect defense in the unconstitutionality of the act. Fitts* v. *McGhee*, 172 U. S. 516."

It will thus be observed that neither the Commissioner nor the Court of Appeals entered any *final* decision upon this point, or, indeed, *any decision whatever*, but left the whole matter of constitutionality of the statute at large, and decided the case upon the other issues presented.

Thereafter, *Gaines & Co.* sued out the writ of error to this Court; but, instead of bringing up the questions which had been *decided* below, expressly abandoned all those questions, saying, at p. 6 of their brief:

"The *sole question* involved in this case is the *constitutionality* of the Trade-mark Registration Act of February 20, 1905."

As there was no *final judgment or decree* upon the matter sought to be reviewed, there was no statutory authority for bringing the case here; and, therefore, the writ of error was properly dismissed for want of jurisdiction. In thus dismissing the Gaines case, this Court cited the case of *Frasch* v. *Moore*, 211 U. S. 1. It becomes necessary therefore to briefly examine the *Frasch* case.

In that case the Examiner had required division between certain claims of an application. The applicant had proffered an appeal to the Examiners-in-Chief, which the Examiner refused to forward. Upon petition to the Commissioner asking that he direct the appeal to be heard, he held that the Examiner was right in refusing to forward the appeal. An appeal was taken to the Court of Appeals of the District of Columbia, which held it did not have

jurisdiction to entertain it. Thereupon *Frasch* filed a petition in this Court for a writ of mandamus, which was dismissed (192 U. S. 566) for the reason that mandamus to the Commissioner, and not an appeal to the Court of Appeals, was the proper remedy. Thereafter through a regular series of appeals (it being an *ex parte* case) the case reached the Court of Appeals of the District of Columbia, which affirmed the decision of the Commissioner.

Thereupon Frasch took an appeal and sued out a writ of error to this Court, which dismissed the appeal and writ of error for want of jurisdiction, and denied an application for a writ of certiorari.

This court in deciding the case said:

> "The decision of the court of appeals sought to be reviewed in the present case is *not final*, but merely ended an interlocutory stage of the controversy, and sent the applicant back to the Patent Office to conform to the meaning and effect of the rule on division of claims as construed by the Commissioner of Patents, and to pursue the application in the form required to allowance or rejection."
>
> * * * * * * *
>
> "By section 4915 a remedy by bill in equity is given where a patent is refused, and reads as follows:
>
> "'Sec. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity;'"
>
> * * * * * * *
>
> "The final decision referred to is obviously the judicial decision *on the bill in equity.*"

As this Court decided that the decision of the Court of Appeals in the *Frasch* case sought to be reviewed was "not final," it became an authority in the *Gaines* case. It does not make that decision an authority in the case at bar, unless it shall be found that the decision which is now sought to be reviewed is also "not final."

We contend that the decision in the case at bar now sought to be reviewed *was* final, and that there is no other means by which the appellant and plaintiff in error can secure relief if it be denied here.

The decision of the Examiner of Trade-marks (Record, p. 16) was:

> "The act approved May 4, 1906, *inhibits* registration where a description of the mark is retained, except where color forms a part thereof."

This was final, and either had to be submitted to, or the matter taken to the Commissioner of Patents, as provided by statute.

It was so taken to the Commissioner, where it was contended that the Examiner's ruling to the effect that description of the mark was prohibited was in fact *without authority of law*, and applicant (Record, p. 26) said:

> "We contend, therefore, that even under the law as it now reads, an applicant *has the right*, if he so elects, to appropriately describe the mark in the statement."

The Commissioner sustained the ruling of the Examiner that the language of the statute was prohibitive of a description.

The Court of Appeals, when the case came before it, affirmed the decision of the Commissioner.

Each of these decisions was *final* and binding upon the applicant. There is no other proceeding known to the law than that which has been adopted in coming to this Court by which these actions may be reviewed.

When the appeal was taken and writ of error sued out it was supposed that the case of *Steinmetz* v. *Allen*, 192 U. S. 543, 48 L. ed. 555, was all the authority which would be necessary. That was a case which was brought here from the same tribunal, and under the same section of the statute, and in that case this Court expressly held that it had jurisdiction.

In view of the contention now raised, however, we call attention to the case of *Bernardin* v. *Duell*, 172 U. S. 576; 43 L. ed. 559, in which a judgment of the Court of Appeals of the District of Columbia in a patent application was affirmed, in which this Court said:

> "By the act of February 9, 1893, the determination of appeals from the Commissioner of Patents, which was formerly vested in the general term of the Supreme Court of the District, was vested in the Court of Appeals, and, in addition, it was provided that 'any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.'
>
> As one of the instrumentalities designated by Congress in execution of the power granted, the office of Commissioner of Patents was created, and though he is an executive officer, generally speaking, matters in the disposal of which he exercises functions judicial in their nature may properly be brought within the cognizance of the courts.
>
> Now, in deciding whether a patent shall issue or not, the Commissioner acts on evidence, finds the facts, applies the

law, and decides questions affecting not only public but private interests; and so as to reissue, or extension, or on interference between contesting claimants; and in all this he exercises judicial functions."

And in *Butterworth* v. *Hoe*, 112 U. S. 50; 28 L. ed. 656, this Court said:

"It is evident that the appeal thus given to the Supreme Court of the District of Columbia from the decision of the Commissioner, is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. Its adjudication, though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded is, nevertheless, *conclusive* upon the Patent Office itself, for, as the statute declares, R. S., Sec. 4914, it 'shall govern the further proceedings in the case.' The Commissioner cannot question it. He is *bound* to record and *obey* it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. The decree of the court is the *final adjudication* upon the question of right; everything after that dependent upon it is merely in execution of it; it is no longer matter of discretion but has become imperative and enforceable."

And in that same case, referring to Section 4915, this Court said:

"It is thereby provided that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is *not* a technical appeal from the Patent Office, like that authorized in Section 4911, *confined to the case as made in the record of that office*, but is prepared and heard upon all competent evidence adduced and upon the whole merits. Such has been the uniform and correct practice in the circuit courts."

The government in its brief (p. 8) cites the case of

B. & P. R. R. v. *Hopkins*, 130 U. S. 210;
United States v. *Lynch*, 137 U. S. 280;
South Carolina v. *Seymour*, 153 U. S. 353, and
Linford v. *Ellison*, 155 E. S. 503.

These cases are to be distinguished from the case at bar.

In *South Carolina* v. *Seymour*, for example, the case arose upon a writ of mandamus to compel the Court to register a trade-mark

under the then existing law, when he had found that the applicant had not a right to registration because it was not engaged in trade outside its own borders. There can be no contention but that this was a question the Commissioner had the authority to decide. In the case at bar we say he had no authority to deny applicant the right to appropriately describe its mark.

It is the validity of the *authority* which is here directly attacked. That the Commissioner in making his pretense of the invalid authority misconstrued the statute, and that, if his construction were correct, the exercise of authority complained of would have been valid, is immaterial. If an officer could escape this jurisdiction in cases like that at bar by merely claiming that he acted according to his own construction of the statute, and as so construed the statute made the act valid, it is difficult to see how or under what circumstances the Court could ever get jurisdiction. Certainly not in a case like that of *Steinmetz* v. *Allen*, which is the authority upon which we principally rely for the jurisdiction of this Court to entertain this case, and for the propriety of this proceeding.

In that case this Court found that a certain regulation, established by the Commissioner of Patents, in the form of a written rule, was not in accordance with the law as construed by the Court.

In this case we ask the Court to find that a certain regulation established by the Commissioner of Patents in and by a certain written opinion or decision is not in accordance with the law when properly construed or interpreted.

There the objectionable act was founded on a written rule of action or procedure established because of a misconception of the statute. Here the objectionable act is a rule of action or procedure contained in a written decision rendered, as we believe, because of a misconception of the statute.

That the Commissioner rendered the decision without first establishing a formal written rule outside the decision seems wholly immaterial. The "validity of a regulation" (appellee's brief, p. 8) established by a *decision* in a certain case is certainly as properly open to attack as the validity of a regulation established by a *written rule*.

Our position is simply this: That the Commissioner of Patents had no authority under the law to deny to an applicant the right

to properly describe the trade-mark sought to be registered—that any such denial is a wholly invalid exercise of his authority.

There is no question here but that the description proposed was a proper one. Indeed, that had been expressly decided at an earlier stage of the case.

The question is not, therefore, *how* the authority was exercised. It is whether the Commissioner had the right to exercise it at all. If he had, the action was valid. If not, it was invalid. We say that when he said the statute *prohibits* descriptions of trade-marks in the statements forming a part of applications for registration, that he assumed to find a law which does not exist.

This was not an "erroneous decision" (appellee's brief, p. 7) in a matter which the Commissioner had authority to decide. He rendered a decision which he had no right to make at all. If, when the Commissioner decides to do, and does, something which no statute gives him the right to do at all, his procedure is not an invalid exercise of "an authority exercised under the United States," he acting at the time by virtue of his official position as Commissioner of Patents, it is difficult to see what sort of an act could be such invalid exercise of authority.

The "*construction* of such statute or authority" as used (appellee's brief, p. 8) is artificial and misleading. It is true that invalidity of the authority which was exercised seems to be because the Commissioner misconstrued the statute, and asserted that he found therein an authority which we think does not exist. But that was not *construing* an authority. It was *assuming* an authority based on a faulty construction of the statute, and therefore an invalid exercise of authority. It was pretended that this authority was "exercised under the United States," so that there seems to be no question but that in this matter at least appellee's contention is unsound.

While it is true that we must refer to the statute to ascertain whether or not it contains authority for the act complained of, and therefore involves a construction of the statute, that is a mere incident to the determining of the validity or invalidity of the authority exercised.

And it was not a case of exercise of "discretion." If, as the Commissioner decided, the statute "inhibits" description, he could not act otherwise than he did. He had no discretion in the matter at all.

Sec. 9 of the Trade-mark Act states that on appeals from the Commissioner to the Court of Appeals of the District of Columbia

> "the same *rules of practice* and *procedure* shall govern in every stage of such proceedings, *as far as the same may be applicable.*"

It does not say that the matters which shall govern shall extend beyond "rules of practice" and "procedure." This does not provide that the same *statutes* shall govern as in patent cases, or that even the "rules of practice and procedure" shall govern any further than "the same may be *applicable.*" Had Congress designed that Sec. 4915 of the Patent Act should be applicable to trade-mark procedure, it certainly would have used language clearly expressing that intention.

In the oral argument I differentiated the *Frasch* case from the case at bar, by pointing out that while in a *patent* case an applicant had a remedy under Section 4915, no such remedy is provided in a *trade-mark* case. This differentiation we still believe to be correct as far as it goes; but it, perhaps did not state the real *fundamental* distinction.

As above pointed out, there must be, under Section 8 of the act of February 9, 1893, a concurrence of two essentials, viz.: (1) finality of judgment or decree, and (2) the specified subject-matter. Where these two things are not concurrently found, there is of course no jurisdiction under this section of the statute, and this Court cannot take cognizance of a case coming from the Court of Appeals of the District of Columbia in which this concurrence is not found.

Such a concurrence was not found in either the *Frasch* case or the *Gaines* case. Therefore the *Frasch* case was an appropriate authority in the *Gaines* case to the point that where there was not a *final* judgment or decree of the court below jurisdiction is not conferred upon this Court to review such judgment. But the appropriate citation of the *Frasch* case in the *Gaines* case does not make the *Frasch* case conclusive of all trade-mark cases originating in the Patent Office and brought here from the Court of Appeals of the District of Columbia, nor does it adjudge that Section 4915 of the Patent Act is appropriate to or could be proceeded under in a trade-mark case.

I may add, for such attention as the Court may see fit to give it, that if I were in the situation of the plaintiff in error in *Frasch*

v. *Moore,* I would urge that the final judgment apparently meant by Congress in the section in question was the final judgment of the Court of Appeals of the District of Columbia, in a proceeding authorized by the statute establishing that court and defining its jurisdiction; and not a final judgment of a different court, in a different proceeding, under a different statute, and upon a different record. But as there is no section in the trade-mark act like or at all corresponding to Section 4915 there seems to be no need to present this matter further than by way of emphasizing that the *Frasch* case can have no possible application to the case at bar, while it is a good authority in the *Gaines* case to the proposition that, to give this Court jurisdiction in cases coming from the Court of Appeals of the District of Columbia, there must be the element of finality of judgment as well as of prescribed subject-matter.

This seems to be a radical and fundamental distinction, entirely sufficient to support our contention.

To take jurisdiction in the case at bar is therefore entirely consistent with *all* the cases of which we have any knowledge, including the *Frasch* case and the *Gaines* case; but to deny jurisdiction, it seems to us, would be to practically overrule the *Steinmetz* case, and to largely discredit *Bernardin* v. *Duell,* and *Butterworth* v. *Hoe.*

Respectfully submitted,

CHESTER BRADFORD,

Of Counsel for Appellant and Plaintiff in Error.

Indianapolis, Ind., January 25, 1909.

In the Supreme Court of the United States.

OCTOBER TERM, 1908.

E. C. ATKINS & COMPANY, APPELLANT AND plaintiff in error,
v.
E. B. MOORE, COMMISSIONER OF PATENTS. } No. 86.

APPEAL FROM AND IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR APPELLEE AND DEFENDANT IN ERROR.

STATEMENT OF THE CASE.

Plaintiffs filed their application for a trade-mark on June 12, 1905, in which it was recited that—

> The trade-mark consists of a symbol composed of the letters "AAA" * * *. The trade-mark is usually displayed on the goods by etching, stamping, or otherwise marking the same upon the blade of the saw, and by inscribing same upon the packages containing such saws. (Rec., p. 4.)

This was amended on August 30, 1905, by adding the sentence—

> The trade-mark is shown with the letters arranged in the form of a monogram. (Rec., pp. 6 and 7.)

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The examiner suggested that the description of the trade-mark should be amended so as to read—

> The trade-mark consists of a monogram composed of the letters "A. A. A." (Rec., p. 7.)

Plaintiffs refused to comply with the suggestion, and appealed from the ruling of the examiner that such amendment should be made to the Commissioner of Patents, who, on February 20, 1906, overruled the decision of the examiner and held that the description was sufficient. (Rec., pp. 9, 11, and 13.)

On April 27, 1906, plaintiffs were notified that their—

> Application for the registration of a trade-mark for a symbol composed of the letters "A. A. A." for saws of all kinds, filed June 12, 1905, serial No. 7998, has been examined and passed for publication, in compliance with section 6 of the act authorizing the registration of trade-marks, approved February 20, 1905. The mark will be published in the Official Gazette of May 15, 1906. (Rec., p. 14.)

On June 21, 1906, the Patent Office sent plaintiffs the following communication:

> Attention is directed to the act approved May 4, 1906, providing for a description of the trade-mark itself only when needed to express colors not shown in the drawing.
>
> Inasmuch as the trade-mark covered by this application can not be registered until after July 1, 1906, when said act takes effect, applicant should direct the cancellation of the pres-

ent description and of all of the preamble to the statement following the words "have adopted for my use," and the substitution therefor of the following words: "the trade-mark shown in the accompanying drawing."

If colors form a material part of the mark, a brief reference thereto should follow.

An amendment as above indicated should be promptly filed to avoid delay in the use of the certificate. (Rec., p. 15.)

Plaintiffs refused to comply with this suggestion, and, on July 16, 1906, the examiner declined to pass the application for registration. (Rec., p. 16.)

A petition was thereupon presented by plaintiffs to the commissioner, seeking to have overruled the action of the examiner (Rec., pp. 17 and 18); but, on November 22, 1906, the petition was denied. (Rec., pp. 31 and 32.) An appeal was prosecuted to the Court of Appeals, and in the notice of appeal the following errors were assigned:

1. That the commissioner erred in holding that an applicant may not include in the statement forming part of an application for a certificate of registration of a trade-mark any description of the trade-mark.

2. That the commissioner erred in holding that the language of the amendment to the trade-mark act approved M[illegible]4, 1906, concerning the description of the trade-mark prohibits any such description.

3. That the commissioner erred in holding that no certificate of registration could issue upon an application filed prior to the act

amendatory of the trade-mark act approved May 4, 1906, after the taking effect of said act, except in accordance with the terms of said act.

4. That the commissioner erred in holding that where a certificate of registration was ready for issue sixteen days before the taking effect of the act amending the trade-mark act approved May 4, 1906, the issue of such certificate of registration should be withheld, because in ordinary course, and to suit the convenience of the Patent Office, such certificate would not ordinarily issue until July 10, 1906, after the act of May 4, 1906, took effect; although it would easily be possible to have issued said certificate before July 1, 1906, by hastening said certificate forward out of ordinary routine.

5. That the commissioner erred in not holding that the language "only when needed to express colors not shown in the drawing," in the act approved March 4, 1906, is, in the legislative intent, permissive and not mandatory.

6. That the commissioner erred in holding that it was impossible to register the mark in question herein until after the act approved May 4, 1906, went into effect, on July 1, 1906.

7. That the commissioner erred in not issuing the certificate of registration prayed for in said application. (Rec., p. 33.)

The errors assigned by plaintiffs to the action of the Court of Appeals in affirming the judgment of the commissioner are substantially the same as those assigned to the action of the commissioner, except

that by the first four assignments it is attempted to draw in question the validity of an authority exercised under the United States. (Rec., pp. 36 and 37.)

In granting the appeal the court stated that—

> The petition for the allowance of an appeal and writ of error to the Supreme Court of the United States in the above-entitled cause is founded on the decisions of the Supreme Court of the United States in the case of *United States ex rel. Steinmetz* v. *Allen* (192 U. S., 543) and *United States ex rel. Lowry* v. *Allen* (203 U. S., 476). (Rec., p. 38.)

BRIEF AND ARGUMENT.

I.

This is not such a case as can be removed to this court by appeal or writ of error, and it should therefore be dismissed.

This court is without jurisdiction for two reasons:

First. The judgment of the Court of Appeals is not final within the meaning of section 8 of the act of February 9, 1893 (27 Stat., 436; Code Dist. Col., sec. 233), which specifies what judgments of that court may be reviewed by this court on appeal or writ of error.

By section 9 of the trade-mark act of February 20, 1905 (33 Stat., 727), it is provided:

> That if an applicant for registration of a trade-mark * * * is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the

> decision of the commissioner by an applicant for a patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings as far as the same may be applicable.

The manifest purpose was to place appeals to the Court of Appeals from decisions of the Commissioner of Patents in proceedings arising under applications for trade-marks, and also the judgments of that court upon such appeals, upon the same footing with such appeals to and judgments thereof in applications for patents.

This court has held at the present term in *Frasch* v. *Moore* (211 U. S., 1), that the judgment of the Court of Appeals in proceedings arising under an application for a patent is not final, and that this court has no jurisdiction to review the same by appeal or writ of error. And, in *Gaines & Co.* v. *Knecht & Son*, No. 52 of the present term, this court has applied the same rule to trade-mark cases.

Second. The matter in dispute is of no certain value, and there is not drawn in question "the validity of * * * a statute of, or an authority exercised under the United States."

Notwithstanding the numerous assignments of error, there are but two questions presented: (1) whether or not the act of February 20, 1905 (33 Stat., 724) as amended by the act of May 4, 1906 (34 Stat., 168), requires any description of the trade-mark to be given in the application, except such as is needed to

express colors not shown in the drawings; and, (2) whether said amendatory act applies to this case inasmuch as said act went into effect July 1, 1906, and the trade-mark was published in the Official Gazette of May 15, 1906, but could not be registered before July 1, 1906.

It is true that in the first two assignments it is insisted that the action of the commissioner in refusing to appellant the right to include a description of the trade-mark in the application and registration thereof was an invalid exercise of authority under the United States; but the validity or invalidity of such action depends upon the *construction* of the statutes and not upon their validity.

In the third and fourth assignments it is also insisted that the rule of practice in the Patent Office governing the practice relating to applications for registration of trade-marks established *by the decision of the commissioner in this case* was an invalid exercise of authority under the United States. But this is but another way of saying that the commissioner misconstrued the statute and rendered an erroneous decision. There is no regulation of the Patent Office by which the commissioner professed to be governed in reaching the conclusion he did, and no such regulation is pointed out by these assignments. The commissioner decided the case wholly upon an interpretation of the statute, and the validity of the statute or of any regulation of the Patent Office has never been questioned.

It is well settled that before this court can take jurisdiction on an appeal or writ of error of a case coming from the Court of Appeals of the District of Columbia on the ground that the validity of a statute of or of an authority exercised under the United States is drawn in question the *validity* and not the *construction* of such statute or authority must be attacked.

Balt. & Pot. R. R. Co. v. *Hopkins* (130 U. S., 211, 226).

United States v. *Lynch* (137 U. S., 280, 285).

South Carolina v. *Seymour* (153 U. S., 353, 358, 360).

Linford v. *Ellison* (155 U. S., 503).

In *South Carolina* v. *Seymour*, the court said:

> In order to come within this clause, the validity and not the construction only of a treaty or statute of the United States, or of an authority exercised under the United States, must be directly drawn in question.

The two cases cited by the Court of Appeals as justifying the granting of the appeal and writ of error, to wit, *Steinmetz* v. *Allen* (192 U. S., 543) and *Lowry* v. *Allen* (203 U. S., 476), are not in point. In each of those cases the *validity* of a regulation adopted by the Patent Office was the question for determination.

Furthermore, the validity of a statute of or an authority exercised under the United States was not questioned in the court below, and the question can not be here raised for the first time.

Arkansas v. *Schlierholz*, 179 U. S., 598, 600.

Lampasas v. *Bell*, 180 U. S., 276, 282, 284.

II.

The act of February 20, 1905 (33 Stat., 724), as amended by the act of May 4, 1906 (34 Stat., 168), does not require any description of the trade-mark to be given in the application, except such as is needed to express colors not shown in the drawings.

By the first of said acts it was provided that the applicant should file an application in writing, which should contain, among other things:

> A description of the trade-mark itself and a statement of the mode in which the same is applied and affixed to goods and the length of time during which the trade-mark has been used. With this statement shall be filed a drawing of the trade-mark, signed by the applicant or his attorney, and such number of specimens of the trade-mark, as actually used, as may be required by the Commissioner of Patents.

By the latter act it was provided that the former act—

> be, and is hereby, amended by inserting after the words "description of the trade-mark itself" the words "only when needed to express colors not shown in the drawings;"

which makes the provision with reference to the description read—

> A description of the trade-mark itself, *only when needed to express colors not shown in the drawing.*

Both the examiner and the commissioner held that this amendment *prohibited* a description of the trade-

mark, except when needed to express colors not shown in the drawing, on the ground that the purpose of the amendment was "to make the registration definite by limiting it to the disclosure in the drawing," and, "to prevent just such an apparently indefinite extension of the scope of the registered mark, by a generic description, as the petitioners contend for." (Rec., p. 31.)

This is manifestly a correct interpretation of the amendment. But, whether the amendment prohibits a description in the application or not, it can not be insisted that after it was passed, the law *required* a description of the trade-mark; and if it did not require it, then it was at least within the discretion of the commissioner whether he would permit the registration of a trade-mark containing such description or not; and his action in refusing registration on account of the presence of a description is not therefore subject to review.

III.

The amendment of May 4, 1906, which went into effect July 1, 1906, applies to the proceedings under appellants' application.

Under the trade-mark statute no rights are vested in the applicant until the registration of the mark. That is the final decree, as it were, and anything done before its entry are but steps in the proceedings leading thereto.

Statutes which affect only procedure apply to proceedings pending at the time they go into effect, un-

less the contrary affirmatively appears from their recitals.

Endlich Interp. Stat., secs. 287 and 288.
2 Lewis Sutherland Stat. Con. (2d ed.), sec. 674.
26 Am. and Eng. Ency., 695.

Inasmuch, therefore, as the trade-mark in question was not registered until after the amendatory act went into effect, the registration thereof had to be made under said amendment, and not under the act of February 20, 1905.

The United States, therefore, insists—

First. That the appeal and writ of error should be dismissed for the want of jurisdiction in this court; and,

Second. If mistaken in this, that the judgment of the Court of Appeals should be affirmed.

J. A. FOWLER,
Assistant Attorney-General.

JANUARY, 1909.

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